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A Mask that Eats into the Face: Images and the Right of Publicity

Rebecca Tushnet^{*}

Abstract:

In their eagerness to reward celebrities for the power of their “images,” and to prevent other people from exploiting those images, courts have allowed the right of publicity to distort the First Amendment. The power of the visual image has allowed courts to create an inconsistent, overly expansive regime that would be easily understood as constitutionally unacceptable were the same rules applied to written words as to drawings and video games. The intersection of a conceptually unbounded right with a category of objects that courts do not handle well has created deep inconsistencies and biases in the treatment of visual and audiovisual media, particularly comics and video games. These problems show up both in First Amendment defenses and in copyright preemption analysis. The possible arguments one might offer for treating images differently are insufficient to justify this disparity. The Article concludes that, absent the distortion produced by images, the right of publicity would properly be understood as sharply limited.

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A Mask that Eats into the Face: Images and the Right of Publicity

“Celebrity,” John Updike wrote, “is a mask that eats into the face.”¹ Just as Updike suggests celebrity changes and damages human beings, courts have allowed the right of publicity to etch itself into the First Amendment in their eagerness to reward celebrities for the power of their “images” and to prevent other people from exploiting those images. The power of the visual image has allowed courts to create an inconsistent, overly expansive regime that would be easily understood as constitutionally unacceptable were the same rules applied to written words as to drawings and video games. The intersection of images with the right of publicity provides a lesson on how badly a misunderstood subject matter can distort the law, as well as on how important it is to provide a clear justification for intellectual property rights so that their proper boundaries may be determined.

The trouble with images didn’t start with the right of publicity, which is a quasi-property right granted by many states that developed out of the right of privacy.² Across fields of law, courts struggle with the regulation of images.³ The association between images and emotion complicates legal approaches that rely on ideas of rationality and interpretive approaches honed on text.⁴ As a result, courts often misjudge the meaning or functions of images. At other times, courts simply treat images differently without providing any justification: the image is so self-evidently distinct from other forms of expression that to point out that it is an image is to explain why it can be regulated when text could not be.

But images have caused extra damage when it comes to the right of publicity. Like images themselves, celebrities (and the fans who provide them with their economic value) have often been associated with emotion, excess, ungovernability and irrationality.⁵ Courts have regularly seemed disgusted with celebrity culture even while allocating economic rights to exploit such irrational preferences. Today, the right of publicity expansively grants celebrities the right to control commercial exploitations of their names, likenesses, voices and often enough their “identities” in any form that those identities are evoked.⁶ This right can be metaphorically shorthand as a right to control “image,” indicating the way in which publicity rights are bound up with the heavily visual culture of the past century that gave us the modern celebrity. This shorthand mirrors one of the key features of visual images: they can seem to convey much more than visual information. A person’s “image” is not just what she looks like, but facts—or

¹JOHN UPDIKE, *SELF-CONSCIOUSNESS: MEMOIRS* 252 (1989) (“Celebrity is a mask that eats into the face. As soon as one is aware of being ‘somebody,’ to be watched and listened to with extra interest, input ceases, and the performer goes blind and deaf in his overanimation. One can either see or be seen.”); cf. *Yale Electric Corp. v. Robertson*, 26 F. 972, 974 (2d Cir. 1928) (Hand, J.) (“[A] reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask.”).

²See generally 2 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 3:1 (2d ed. 2014).

³See Elizabeth G. Porter, *Taking Images Seriously*, COLUM. L. REV. (forthcoming 2014), available at <http://perma.cc/GM26-2AFZ>; Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright Law*, 125 HARV. L. REV. 683 (2012).

⁴See Tushnet, *supra* note 3, at 689.

⁵See Mark Bartholomew, *A Right is Born: Celebrity, Property, and Postmodern Lawmaking*, 44 CONN. L. REV. 301, 307, 331–32 (2011) (discussing the legal history of viewing celebrity as emotional, though ultimately also as valuable, as the locus of legal interest shifted from the irrational preferences of audiences to the manipulative and quantifying powers of experts to create and define celebrity value).

⁶*White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992).

audiences’ beliefs—about her. We may caution ourselves not to judge books by their covers, but we routinely do so. Because the “image” is so rich in meaning, references to it may seem to be taking—even misappropriating—something very substantial, which justifies a celebrity’s claim to control.

Unsurprisingly, the intersection of a nearly unbounded right with a category of objects that courts don’t handle well has led to some very bad decisions. Currently, the lower courts are in disarray about how to treat the right of publicity, especially when it comes into conflict with First Amendment rights to create noncommercial expression, or with copyright law. The pervasive entanglement of the right of publicity with the regulation of images has made it more difficult to understand the appropriate scope of the right. But if, as everyone seems to agree, the Constitution precludes requiring a celebrity’s consent before a writer can pen a biography of her, the result should be the same when a comic artist picks up a pencil or a programmer opens a file.

Part I of this Article offers an abbreviated history of the right of publicity, focusing on its relation to the regulation of images and its escape from serious First Amendment scrutiny. Parts II and III examine publicity cases involving visual art forms, mainly comic art and video games. Part IV examines possible distinctions that might be offered to justify giving celebrities broader rights to control visual representations than other methods of evoking their identities. Part V considers the relationship of these issues to copyright preemption, which operates to displace state-law causes of action that interfere with federal copyright policy. I conclude that, to the extent a right of publicity is appropriate at all, it should not extend to noncommercial speech—even when that speech comes in the form of images instead of words.⁷

I. History

A. From Privacy to Publicity

Before the right of publicity had a name as a separate right, courts and commentators wrote in terms of “privacy,” meaning a person’s control over the extent of dissemination of information—or really, when the relevant rights began to develop in earnest, dissemination of *images*. Visual culture is a hallmark of modern Western life. Images of ourselves and other people are crucial, often predominant, parts of that culture.⁸ Photography, and then moving pictures, became objects of public concern. Professor Samantha Barbas notes that “new technologies of visual representation and the fragmented and unstable nature of interpersonal relations in the city generated new anxieties around image, identity, and self-presentation in public.”⁹ With mass media rising and traditional social ties declining, “appearances, first impressions and images became matters of great individual and collective significance.”¹⁰ The legal right to privacy developed in this context.¹¹

⁷As explained below, common-law copyright might justify protecting entire unfixed performances, *see supra* note 192 and accompanying text, but that is such a small part of the modern right of publicity that I am omitting it for now.

⁸Samantha Barbas, *The Laws of Image*, 47 NEW ENG. L. REV. 23 (2012).

⁹*Id.* at 25–26.

¹⁰*Id.* at 26.

¹¹*Id.*

The new privacy right grew up alongside the increasing use of images in advertising. Specifically, advertisers took advantage of new technologies in a “binge of image appropriation,”¹² and they often didn’t bother to get the consent of photographic subjects when they purchased images from photographers. The perceived intimacy of a photograph of a person’s face made this appropriation seem particularly outrageous.¹³ As the public, as well as famous people, became more comfortable with commercializing such images, courts started to identify the harm of such uses less as insults to dignity and privacy and more as violations of a right to control and profit from any commercial uses.¹⁴ An image, described by the Supreme Court as a “short cut from mind to mind,”¹⁵ here became private property, not a public pathway.

The right of publicity thus detached from the right of privacy and began its development as a separate, specifically commercial right of well-known people in the mid-twentieth century. Eventually, its expansion would collide with the expansion of the First Amendment to protect entertainment as speech. But unlike the centuries-old cause of action for defamation, which was cut down in numerous and vital ways by the rise of the First Amendment as a constraint on tort claims,¹⁶ the right of publicity would fare far better in this collision. Perhaps the right of publicity, which protects celebrities’ interest in getting paid when someone else refers to them, simply seems weightier to the modern mind than the classic dignity interest in maintaining a person’s good reputation. Even if this calculation has not been made explicitly, that is the functional result of changes in doctrine over the years.

A. Modern Publicity Rights and Non-Advertising Speech

There is no federal right of publicity, and different states approach it somewhat differently. New York, for example, has only a statutory right, and it is expressly limited to uses of a person’s name, picture, portrait or voice for advertising or purposes of trade; the courts have interpreted its scope narrowly.¹⁷ Unfortunately, many other states—including litigation and entertainment powerhouse California¹⁸—are not so limited, and define the right of publicity to include for-profit speech by artists if the speech “exploits” a person’s identity.¹⁹

¹²*Id.* at 39 (citing Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 125, 157–58 (1993)).

¹³*Id.* at 40 (citing Robert E. Mensel, *Kodakers Lying in Wait: Amateur Photography and the Right of Privacy in New York, 1885-1915*, 43 AM. Q. 24, 32 (1991)).

¹⁴Barbas, *supra* note 8, at 65–66; Bartholomew, *supra* note 5, at 328–29.

¹⁵*W. Va. State Bd. of Educ. v. Barnette*, 319 U.S. 624, 632 (1943).

¹⁶Defamation plaintiffs who are public officials or public figures are now required by the First Amendment to show both falsehood and malice—deliberate lying or reckless disregard of the truth. *See New York Times Co. v. Sullivan*, 376 U.S. 254, 279–80 (1964) (public officials); *Curtis Publ’g Co. v. Butts*, 388 U.S. 130, 164 (1967) (public figures). Private persons involved in matters of public concern must prove, at a minimum, negligence to recover. *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 347–48 (1974).

¹⁷*See* N.Y. CIV. RIGHTS LAW § 51 (McKinney 2014) (providing a cause of action when a person’s “name, portrait, picture or voice is used within this state for advertising purposes or for the purposes of trade” without the person’s written consent); *Hoepker v. Kruger*, 200 F. Supp. 2d 340, 348–49 (S.D.N.Y. 2002) (explaining that art, even for-profit art, is not within the scope of the New York right).

¹⁸*See* Cal. Civ. Code § 3344(a) (statutory right of publicity protecting “name, voice, signature, photograph, or likeness” against uses “on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services” (emphasis added)); *Stewart v. Rolling Stone LLC*, 105 Cal. Rptr. 3d 98, 111 (Cal. Ct. App. 2010) (identifying the elements of the common law claim as: “(1) the defendant’s use of the plaintiff’s identity; (2) the appropriation of plaintiff’s name or likeness to defendant’s

The right of publicity is easiest to defend as to unauthorized uses of a person's identity in advertising, which often (though not always) raise risks of false endorsement. Advertising is not, however, my primary concern. Commercial speech is putatively afforded lower constitutional protections compared to noncommercial speech. Moreover, at least in standard instances of false endorsement in advertising, the right of publicity overlaps with trademark law and furthers a similar interest in avoiding consumer deception. Because of the lesser First Amendment rights and greater public interest at issue in deceptive advertising cases, I will focus on speech that is not advertising and would otherwise be categorized as noncommercial and fully protected under First Amendment doctrine.²⁰

Noncommercial speech has great significance for the right of publicity. Despite the slow expansion of the right in other significant ways (such as survival upon the celebrity's death),²¹ the right of publicity reached beyond pure advertising almost from the beginning. *Haelan Laboratories v. Topps Chewing Gum*, a classic early case, found a violation of a baseball player's right of publicity in the unauthorized use of his name and picture on baseball cards sold in packs with gum.²² In today's language, this was a "promotional goods" case: the product that buyers were seeking was, at least in part, precisely a representation of baseball players (and for many collectors, the gum was completely beside the point).²³ Because this case was decided before the First Amendment was understood to protect entertainment, even full narratives such as movies,²⁴ it is not surprising that courts gave little thought to the advertising/non-advertising divide when confronted with mere baseball cards sold for profit.²⁵

advantage, *commercially or otherwise*; (3) lack of consent; and (4) resulting injury" (emphasis added and internal quotation marks omitted)).

¹⁹The *Restatement (Third) of Unfair Competition*, followed by many states lacking clear precedent about the scope of common-law rights, also defines the right of publicity in this way. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. d (1995) ("The right of publicity protects the commercial value of a person's identity.")

²⁰See, e.g., *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501–02 (1952) (holding that "expression by means of motion pictures is included within the free speech and free press guaranty" in the Constitution, even though the production, distribution and exhibition of a film "is a large-scale business conducted for private profit").

²¹Bartholomew, *supra* note 5, at 309–15 (discussing the significant limits imposed on the right until the 1980s and 1990s); see also Barbas, *supra* note 8, at 25 ("Reputation, a mode of social evaluation historically associated with stable and enduring communities, is based on appraisals and judgments accrued over time. Image, by contrast, is the representation of self that one constructs and presents in a world defined by mobility and relatively transient social relations: the fleeting contacts of the city, the momentary connections of the world wide web." (footnote omitted)).

²²*Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866 (2d Cir. 1953); see also 1 MCCARTHY, *supra* note 2, § 1:26 (noting that *Haelan* was the first case to use the term "right of publicity").

²³See William K. Ford & Raizel Liebler, *Games Are Not Coffee Mugs: Games and the Right of Publicity*, 29 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 8–9 (2012) ("Judge Frank's opinion actually described [*Haelan*] largely in terms of advertising, suggesting the court viewed baseball cards as secondary to the chewing gum, a dated view of baseball cards even in 1953. Originally, baseball cards may have been a promotional gimmick to sell gum, but gum ceased to be the primary product long ago, maybe even before the *Haelan* decision." (footnotes omitted)).

²⁴*Burstyn*, 343 U.S. 495 (rejecting *Mut. Film Corp. v. Indus. Comm'n of Ohio*, 236 U.S. 230 (1915), which held that movies were not protected speech).

²⁵See Diane Leenheer Zimmerman, *Who Put the Right in the Right of Publicity?*, 9 DEPAUL-LCA J. ART. & ENT. L. 35, 56, 58–59 (1998) (explaining that the right of publicity arose when commercial speech, including entertainment speech, was deemed unworthy of First Amendment protection and that courts continued applying the old right of publicity rules without using modern First Amendment categories of protected speech).

Over time, the conflict between the right of publicity and the First Amendment should have become more sharply framed. Still, the Supreme Court's first encounter with the right resulted in a rout for the First Amendment. In *Zacchini v. Scripps-Howard Broadcasting Co.*, a television station filmed and broadcast a trick performer's entire act, and the Court held that, by reproducing—"appropriating"—the entirety of his performance, the station had violated the right of publicity, even though this was noncommercial speech (that is, speech that was more than an advertisement proposing a commercial transaction).²⁶ The First Amendment did not protect the station's actions because the right of publicity served the goal of incentivizing such performances, similar to common-law copyright for unpublished works.²⁷ This was the Court's sole direct pronouncement on the right of publicity to date. Apparently freed from First Amendment constraints, the right proceeded to expand far beyond protecting against the reproduction of entire performances.²⁸

Subsequent cases in lower courts found valid publicity rights claims in everything from a humorous reference to "Don's Henley" in an ad for henley shirts²⁹ to the use of a blonde-wigged robot next to the Wheel of Fortune display in an ad for a videotape recorder, evoking Vanna White.³⁰ Now, the use of a celebrity's "identity," not just her exact name, image or voice, can in some states—including California—lead to liability. The key cases expanding the concept of "identity" involved advertising, but plaintiffs also sued noncommercial speakers, sometimes successfully.³¹ Unlike the television station in *Zacchini*, the defendants in these more recent cases did not copy entire performances. Often, they instead created realistic representations of the plaintiffs. Nonetheless, courts have applied *Zacchini* broadly to allow right of publicity claims against noncommercial speech, without asking whether the Court's First Amendment reasoning was limited to cases in which an entire value-generating performance was copied.

²⁶*Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 561 (1980) (defining commercial speech as "expression related solely to the economic interests of the speaker and its audience"). *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575–76 (1977), labeled the station's speech as commercial because it was made for profit, but subsequent cases have clarified that non-advertising speech made for profit is noncommercial for First Amendment purposes. *See, e.g., Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 67 (1983) (holding that economic motivation for speech by itself does not make speech commercial).

²⁷*Zacchini*, 433 U.S. at 576 ("[T]he protection [afforded by the right of publicity] provides an economic incentive for [the performer] to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws.").

²⁸K.J. Greene, *Right of Publicity, Identity, and Performance*, 28 SANTA CLARA COMPUTER & HIGH TECH. L.J. 865, 881 (2012) ("What is rather striking about the modern right of publicity is how often performance has nothing to do with anything."); Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 392 (1999).

²⁹*Henley v. Dillard Dep't Stores*, 46 F. Supp. 2d 587 (N.D. Tex. 1999).

³⁰*White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992).

³¹*See, e.g., RESTATEMENT (THIRD) OF UNFAIR COMPETITION* § 47 cmt. b (1995) ("An unauthorized appropriation of another's name or likeness for use on posters, buttons, or other memorabilia is . . . ordinarily actionable as an infringement of the right of publicity."); *see also Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 811–12 (9th Cir. 1997) (holding that "Cheers"-themed bars that included robots simulating characters from the show could violate the right of publicity); *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 221 (2d Cir. 1978) (holding that a poster depicting Elvis Presley infringed the right of publicity); *Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201, 1214 (N.D. Ill. 1981) (holding that T-shirts depicting band logos violated the right of publicity), *aff'd on other grounds*, 735 F.2d 257 (7th Cir. 1984); *Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697 (Ga. 1982) (holding that sculptures of Dr. Martin Luther King, Jr. violated his right of publicity); *see generally* Jennifer E. Rothman, *Commercial Speech, Commercial Use and the Intellectual Property Quagmire* (Oct. 10, 2014) (unpublished manuscript) (on file with Columbia Journal of Law & the Arts).

As the law has developed, creators who make realistic depictions of celebrities are protected if they work in textual media.³² Biographers win in the rare circumstances they're dragged into court,³³ as did the writer of a highly fictionalized account in which an archbishop plotted the assassination of the Soviet Premier.³⁴ Indeed, in noncommercial speech cases, the mere use of biographical information in textual form often doesn't even seem to count as "appropriation" of something of value.³⁵ While "name" was part of the very first definitions of what the right of publicity protects and still remains part of the standard list of protected attributes, it's lost pride of place to the image.³⁶ For example, the Eleventh Circuit allowed a right of publicity claim (probably better understood as a right of privacy claim) based on the publication of photos of a murder victim, but not based on the text of the accompanying story reporting on her life history.³⁷

Ordinary citizens suing for misappropriation of their personal (non-image) data for private benefit have also generally failed, even when the relevant jurisdiction appears to

³²See F. Jay Dougherty, *All the World's Not a Stooge: The "Transformativeness" Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM. J.L. & ARTS 1, 2, 6–7, 49 (2003) (noting divergent results in image and text cases, even when works all depict individuals without their consent).

³³See, e.g., *Matthews v. Wozenkraft*, 15 F.3d 432 (5th Cir. 1994) (holding that a publicity claim could not be based on biographical novel); *Sidis v. F-R Publ'g Corp.*, 113 F.2d 806 (2d Cir. 1940) (holding that New York's statutory right of publicity did not cover either text or image constituting a biographical sketch of a former child prodigy); *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978) (holding that New York's statutory right of publicity did not cover a fictionalized account, in film and novel form, of true incident that occurred in the life of Agatha Christie); *Frosch v. Grosset & Dunlap, Inc.*, 427 N.Y.S.2d 828 (N.Y. App. Div. 1980) (same, for Marilyn Monroe's name and images in biography); *Rosemont Enters., Inc. v. Random House, Inc.*, 294 N.Y.S.2d 122 (N.Y. Sup. Ct. 1968) (same, for Howard Hughes; primary focus was defamation, but the court also rejected a right of publicity claim). Invasion of privacy and defamation remain potential claims in such text-focused cases, but those claims have their own First Amendment constraints and are much more difficult for plaintiffs to win, given that plaintiffs must show that the *content* of the challenged work offends important principles. By contrast, the right of publicity applies regardless of the truth, falsity, offensiveness or inoffensiveness of the content.

³⁴*Marcinkus v. NAL Publ'g, Inc.*, 522 N.Y.S.2d 1009, 1010 (N.Y. Sup. Ct. 1987); see also *Matthews v. Wozenkraft*, 15 F.3d 432 (5th Cir. 1994) (fictionalized novel protected against right of publicity claim).

³⁵Matters are different in cases about classic advertising uses. See, e.g., *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407 (9th Cir. 1996) (recognizing a right of publicity claim based on use of a name in a conventional advertisement); *Henley v. Dillard Dep't Stores*, 46 F. Supp. 2d 587, 587–88 (N.D. Tex. 1999) (same).

³⁶Names are not completely defunct as subjects of litigation. See *Ross v. Roberts*, 166 Cal. Rptr. 3d 359 (Cal. Ct. App. 2013) (rejecting right of publicity claim by notorious drug dealer Rick Ross against rapper who adopted the name Rick Ross and rapped as if he were a notorious drug dealer). Recently, the licensor of James Dean's right of publicity sued Twitter for refusing to suspend the @JamesDean username, which mainly posts observations about and by deceased actor James Dean, using the third person to describe him. See *James Dean, Inc. v. Twitter, Inc.*, No. 29D01-1213-CC, 2013 WL 7172609, at *8–9, *19–34 (Ind. Super. Ct. Dec. 31, 2013), *notice of removal filed*, No. 14-cv-00183, 2014 WL 540380 (S.D. Ind. Feb. 7, 2014). Twitter's impersonation policy bans deceptive impersonation, but not parody, fan accounts or otherwise unbelievable attributions. See *Impersonation Policy*, TWITTER, <http://perma.cc/A7NB-HXQD?type=source> (last visited Oct. 19, 2014). Since the @JamesDean account is not commercial, only an extremely expansive right to control references to a celebrity could give the licensor a legal remedy. The Twitter account is presently suspended, though Twitter has made no public statement about the litigation. It might also be worth noting that some countries, such as France and Germany, protect name and likeness separately, though protection may overlap. See Mary LaFrance & Gail H. Cline, *Identical Cousins: On the Road with Dilution and the Right of Publicity*, 24 SANTA CLARA COMPUTER & HIGH TECH. L.J. 641, 659 & nn.101, 104-05 (2008).

³⁷*Toffoloni v. LFP Publ'g Grp., LLC*, 572 F.3d 1201 (11th Cir. 2009).

authorize non-celebrity claims.³⁸ The result in these commercial data mining cases is of particular note because in other cases, the right of publicity protects against free riding—that is, a defendant benefiting somehow from information about the plaintiff without consent or payment. The harm to the plaintiff then stems from that lack of consent and payment. Yet something about the dryness of the data (or its internal, invisible use) seems to make it less worthy of protection from free riding than images are.³⁹

In these cases, defendants who took only nonvisual information didn't seem to interfere with an interest valuable enough to protect. At the same time, because an image so often seems equivalent to the person being represented—as if the depicted person is herself transported to appear before the viewer—courts can easily understand images as *less* valuable for free speech purposes than other forms of communication, because they provide less information (even though the objection to use of images is usually that they show *too much*).⁴⁰ In one case, for example, a magistrate judge concluded that sales of a news photo could constitute misappropriation when placed alone on T-shirts or mugs: A picture with accompanying explanatory text “alongside an undisputedly legitimate news article” sold for profit would be fully protected news under the First Amendment, whereas a picture sold “unaccompanied by any information” regarding the contents might “cross[] the line from the mere ‘giving of information’ to a ‘sensational prying into private lives for its own sake.’”⁴¹ But if the picture adds anything to the text (and thus deserves First Amendment protection as part of the story), the incremental information that it adds must be in some way newsworthy.⁴² Giving a full account of an event has never been a requirement for First Amendment protection, absent defamation. Nonetheless, the court required pictures to be accompanied by words in order to be newsworthy.

Although the case law establishes special protections for nonvisual uses, not all noncommercial, nontextual speech yields to the right of publicity. Defendants who produce conventional narratives, including movies, do reasonably well. Courts now find it easy to understand that both books and films are at the core of the First Amendment's protection for speech, even if they are fictional.⁴³ The fact that books often contain photos hasn't been a barrier

³⁸See, e.g., *Dwyer v. Am. Express Co.*, 652 N.E.2d 1351 (Ill. App. Ct. 1995) (names, addresses and spending information used for commercial purposes were not “appropriated” because the information had no value to plaintiffs, despite its commercial value to defendants).

³⁹Cf. *Christoff v. Nestle USA, Inc.*, 213 P.3d 132 (Cal. 2009) (right of publicity claim of a former model for use of his image on the label for Taster's Choice instant coffee; statute of limitations was the only barrier to recovery); *Cohen v. Herbal Concepts, Inc.*, 473 N.Y.S.2d 426 (N.Y. App. Div. 1984) (finding that “portrait or picture” in state privacy law covered “any representation,” not just faces, and thus a picture featuring back of nude woman was actionable if friends and family could identify her from the image).

⁴⁰Tushnet, *supra* note 3, at 707–08.

⁴¹*Peckham v. New England Newspapers, Inc.*, 865 F. Supp. 2d 127 (D. Mass. 2012) (Neiman, J.).

⁴²Cf. *Campbell v. MGN Ltd.*, [2004] UKHL 22, [2004] 2 A.C. 457 (H.L.) at [72] (Lord Hoffman) (arguing that “a photograph is in principle information no different from any other information” in a case involving photos of the supermodel Naomi Campbell).

⁴³See, e.g., *Tyne v. Time Warner Entm't Co.*, 901 So. 2d 802 (Fla. 2005) (holding that Florida's right of publicity did not apply to a movie, a fictionalized account of a fishing boat lost in a storm, that did not directly promote any other product or service). Even when the “narrative” is extremely limited, live-action video generally escapes right of publicity controls. See, e.g., *Lane v. MRA Holdings, LLC*, 242 F. Supp. 2d 1205 (M.D. Fla. 2002) (rejecting claim against the “Girls Gone Wild” series, which offers videos of inebriated young women, because use of image in video and on video cover was not for “commercial” purpose).

to their protection, even though the same photos sold alone could well be found to violate the right of publicity⁴⁴—the image, it seems, is protected if it’s sufficiently explained.

However, realism in other media, particularly pictures and video games (the narratives of which do not resemble conventional sequential narratives and are often discounted by courts focusing on their visual aspects), remains risky for creators. And the law is shaky enough to be worth litigating for nonfiction films: Recent cases allege that the NFL violated players’ rights of publicity by including footage of them in historical films. The NFL settled some of these claims and then won summary judgment on its First Amendment defense against the players who opted out of the settlement, but no court of appeals has yet spoken on the matter.⁴⁵ A California federal district court recently ruled that college football players have a right of publicity interest in being compensated for television broadcasts of games.⁴⁶ Written works, meanwhile, have been left in a uniquely privileged position. As I will argue in the next two Parts, the presence of images causes courts to be willing to break the commercial/noncommercial barrier and condemn non-advertising speech as infringing.

II. Comic Sans Consistency

Part I’s abbreviated history explains that the right of publicity is large and potentially invasive of artistic and creative speech. This Part explores several key right of publicity cases involving comic art. Because courts have refused to draw a line between commercial and noncommercial speech, they instead developed First Amendment defenses for art that only protect certain kinds of creativity and stylistic choices.

Difficulties in the legal treatment of comics may be unsurprising, because some theorists maintain that comics are uniquely difficult to interpret, at least in the words that are courts’ stock in trade.⁴⁷ Comic art’s legal troubles are related to the ways in which it crosses boundaries and

⁴⁴See also *Titan Sports, Inc. v. Comics World Corp.*, 870 F.2d 85 (2d Cir. 1989) (finding that a publisher could be liable for distributing “magazines” if they were actually sold in order to distribute posters of wrestlers); *Mendonsa v. Time, Inc.*, 678 F. Supp. 967 (D.R.I. 1988) (finding that the plaintiff, who was allegedly the sailor in the famous Alfred Eisenstadt photograph of a sailor kissing a woman in Times Square on V-J Day, stated a valid right of publicity claim against *Life* magazine for offering limited edition prints of the photo); cf. *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639 (Cal. Ct. App. 1995) (holding that a newspaper did not violate right of publicity by selling “posters” that were replicas of entire newspaper pages, including but not limited to prominent images of football star Joe Montana).

⁴⁵See *Dryer v. Nat’l Football League*, No. 09-2182, 2014 WL 5106738 (D. Minn. Oct. 10, 2014); *Culp v. NFL Prods. LLC*, No. 13-7815 (NLH/JS), 2014 WL 4828189, at *1 (D.N.J. Sept. 29, 2014).

⁴⁶See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, No. C 09-1967, 2014 WL 1410451 (N.D. Cal. Apr. 11, 2014), at *7–11 (holding that athletes’ right of publicity extended to full broadcasts of their games and reserving judgment on its extension to clips and highlight footage in some commercial speech), *aff’d on other grounds*, 724 F.3d 1268 (9th Cir. 2013); accord *O’Bannon v. Nat’l Collegiate Athletic Ass’n*, No. C 09-03329, 2014 WL 3899815, at *25 (N.D. Cal. Aug. 8, 2014) (reaffirming the court’s rejection of the NCAA’s claim that “the First Amendment and certain state laws preclude student-athletes from asserting any rights of publicity in the use of their names, images, and likenesses during live game telecasts”).

⁴⁷See, e.g., SCOTT MCCLOUD, *UNDERSTANDING COMICS: THE INVISIBLE ART* (Mark Martin ed., HarperPerennial 1994) (arguing that comics’ combination of words and images requires unique analysis); Greg M. Smith, *Surveying the World of Contemporary Comics Scholarship: A Conversation*, 50 CINEMA J. 135, 141 (2011) (statement of Scott Bukatman, Professor of Film & Media Studies, Stanford Univ.) (“Greg asks whether there’s something about comics that makes them particularly difficult to analyze, and I’d answer yes, without being entirely sure of what the

is therefore culturally devalued.⁴⁸ “Comics aren’t novels, so they aren’t understood as high status and inherently meaningful. They aren’t pure visual art, so they don’t enjoy the insulation of the transcendent power of nonverbal art. They are mixed, not purebred, and they get treated as such.”⁴⁹ Over a hundred years after the art form became widespread, comics still generate unease and misunderstanding. The peak of anti-comic moral panic has passed,⁵⁰ but when legal battles do occur, courts struggle with the hybridity and liminality of comic art.

Within right of publicity law specifically, courts have treated comics as less valuable than other kinds of art. For example, *Doe v. TCI* found that a comic book, *Spawn*, violated a hockey player’s right of publicity because a minor character, a mob enforcer, bore the same name as the hockey player (Tony Twist), and the creator admitted that—as a hockey fan—he’d used Twist’s name and had even promoted the comic at hockey-related events.⁵¹ In deciding that the comic artist had no free speech defense, the Missouri Supreme Court ruled that, “[i]f a product is being sold that *predominantly* exploits the commercial value of an individual’s identity, that product should be held to violate the right of publicity and not be protected by the First Amendment.”⁵² Remarkably, the court found that the entire comic book *Spawn* was *predominantly* an exploitation of Tony Twist (the hockey player), even though Tony Twist (the character) was a minor character in a story about an undead superhero who’d been released from Hell.⁵³ The court therefore upheld a damages award that ultimately reached \$15 million.⁵⁴

problem is. Comics are indeed difficult to paraphrase, much more so than film. I can describe a shot in loving, evocative language far more easily than I can a comics sequence (“Then the next panel on the bottom tier is taller to show how the body is moving . . .” []); see also Marc H. Greenberg, *Comics, Courts & Controversy: A Case Study of the Comic Book Legal Defense Fund*, 32 LOY. L.A. ENT. L. REV. 121, 143, 157 (2012) (discussing various decisions that fail to come to grips with the merger of words and art in comics and that treat comic art as less worthy and meaningful than words).

⁴⁸See, e.g., JARED GARDNER, PROJECTIONS: COMICS AND THE HISTORY OF TWENTY-FIRST-CENTURY STORYTELLING ix (2012) (“[A] series of critical misconceptions and misunderstandings . . . have only served to compound the error of the name [comics]: that they are directed primarily at juvenile audiences; that they are easy or transparent reading; that they are, if not beneath contempt, certainly not worth notice from those whose job it is to determine what is, indeed, worthy of notice.”); MARC H. GREENBERG, COMIC ART, CREATIVITY AND THE LAW 13 (2014) (“Creators in the comic art genre have often encountered . . . cultural bias about the blended nature (graphic art and text) found in many comic works. . . . [A] number of legal doctrines . . . have failed to recognize that comics are literary works Rather, comic art, particularly in the United States, has been characterized as ‘low art’.” (footnote omitted)).

⁴⁹Tushnet, *supra* note **Error! Bookmark not defined.**, at 741 (footnote omitted); see also Gardner, *supra* note 48, at xi (“As a form that works with traditionally incommensurate systems of meaning—text and image—to tell its story, [comic art] also requires its readers at every turn to make active decisions as to how to read the two in relationship to a larger narrative.”).

⁵⁰In 1948, for example, a Los Angeles county ordinance made it a misdemeanor to sell or give anyone under eighteen a publication that depicted “an account of crime . . . through the use of drawings or photographs”; similar bans were widespread and widely applied against comics. BRADFORD W. WRIGHT, COMIC BOOK NATION: THE TRANSFORMATION OF YOUTH CULTURE IN AMERICA 98–99 (rev. ed. 2003).

⁵¹*Doe v. TCI Cablevision*, 110 S.W.3d 363, 371–72 (Mo. 2003) (en banc).

⁵²*Id.* at 374, citing Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity—Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 488–98 (2003) (emphasis added).

⁵³The Missouri Supreme Court was evidently affected by the fact that the comic was promoted at hockey events—but the comic as a whole was still what was at issue; the award upheld was not for those promotions but for the comic itself.

⁵⁴See *Doe v. McFarlane*, 207 S.W.3d 52 (Mo. Ct. App. 2006) (affirming revised award).



In order to reach the conclusion that *Spawn* predominantly exploited Tony Twist, the Missouri Supreme Court implicitly defined a subset of *Spawn* (the part featuring Tony Twist) as the product, and then held that the non-exploitative parts were less important than the exploitative parts. Yet the court referred neither to the plot of *Spawn* nor to its visuals, neither of which bear any relationship to Tony Twist the hockey player—an example of considering images worthless, which here had the effect of stripping First Amendment protection from a primarily visual medium even without the use of an image of the plaintiff. The court ignored the comics themselves except as commercial products, as if they were full of cornflakes instead of art.⁵⁶ This assessment was undoubtedly assisted by the culturally liminal status of comic books—kid stuff, not worthy of dignity, not as important as “real” books. Even though the character’s name was the source of liability, it is impossible to imagine a similar victory against a novel with a minor character named Tony Twist:⁵⁷ the prominence of the images devalued the artwork, then dropped out of the analysis.

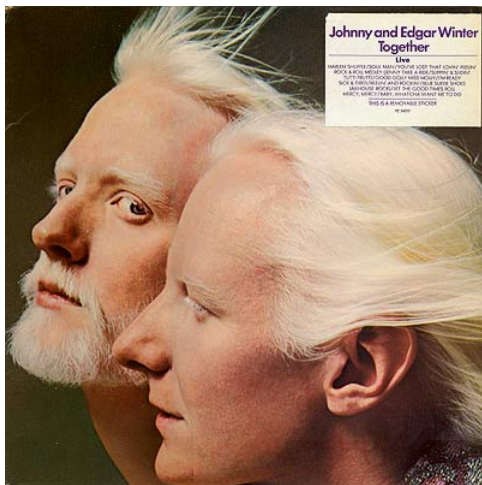
There is also a directly contradictory comics case decided under California law, *Winter v. DC Comics*. *Winter* held that the characters of the Autumn brothers, a pair of evil albino twins named Johnny and Edgar, did not infringe the publicity rights of the Winter brothers, a pair of albino twins with a singing career and with the same first names as the Autumn brothers.⁵⁸

⁵⁵TODD MCFARLANE, SPAWN #47 (Apr. 1, 1996).

⁵⁶Right of publicity law generally struggles to distinguish that which is protected speech from that which is unprotected merchandising, but it is notable that the unprotected “merchandise”—like posters, mugs, magnets and so on—are media that are particularly likely to feature images, either as their most prominent feature or without any accompanying words at all.

⁵⁷*Cf. Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) (holding that the use of the movie title FRED AND GINGER to refer to the two main characters, who were not Fred Astaire and Ginger Rogers but used their names as nicknames, was not a violation of right of publicity or trademark law because of the filmmaker’s expressive interest in using the name). Several movies and television shows feature characters who share the names of famous people. *See, e.g., A FISH CALLED WANDA* (Prominent Features 1988) (character named Archie Leach, better known as Cary Grant); *COOL RUNNINGS* (Walt Disney Pictures 1993) (character named Yul Brenner); *OFFICE SPACE* (20th Century Fox 1999) (Michael Bolton); *SHORTBUS* (Fortissimo Films 2006) (character named Jennifer Aniston); *Due South* (CTV television series 1994–99) (character named Maggie Thatcher); *Grace Under Fire* (ABC television series 1993–98) (character named Grace Kelly, with relatives named Jean Kelly and Emmet Kelly, among others); *Twin Peaks* (ABC television series 1990–91) (character named Harry S. Truman). Books, as well, feature similar characters, such as, John Connolly’s supernatural detective series *Charlie Parker* (named for the title character), Mary Janice Davidson’s *Undead and Unwed* series (character named Elizabeth Taylor), Bill Fitzhugh’s *Pest Control* (character named Bob Dillon), Tao Lin’s, *Richard Yates* (characters named Dakota Fanning and Haley Joel Osment) and C. E. Murphy’s *Walker Papers* series (character named Billy Holiday).

⁵⁸*Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003).



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Some further background is necessary to understand what happened in *Winter*, in which the court used a variant of the transformativeness test adapted from copyright's fair use test. Transformativeness, according to this approach, protects creative works when their (market) value comes from the creativity added by the artist and not from the celebrity's identity. The California Supreme Court first announced its transformativeness test in *Comedy III Productions, Inc. v. Gary Saderup, Inc.* as a way to protect artists' First Amendment interests while allowing celebrities to control things like T-shirts and posters that featured their images.⁶¹ Thus, in *Comedy III*, the court found that an artist infringed the Three Stooges' right of publicity by creating standard charcoal portraits and selling prints and T-shirts reproducing those portraits.⁶²



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Comedy III recognized that its transformativeness standard apparently posed risks to a number of artistic works, but announced that other depictions would still be protected by the

⁵⁹EDGAR WINTER & JOHNNY WINTER, TOGETHER: EDGAR WINTER AND JOHNNY WINTER LIVE (Blue Sky 1976).

⁶⁰JOE R. LANSDALE, TIMOTHY TRUMAN & SAM GLANZMAN, JONAH HEX: RIDERS OF THE WORM & SUCH #4 (June 1, 1995). Along with their shared albinism, "Johnny Autumn wears a black stovepipe hat—a hat similar to one that Johnny Winter often wore at rock shows when he performed." Greenberg, *supra* note 48, at 77.

⁶¹*Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808–10 (Cal. 2001).

⁶²*Id.* at 811.

⁶³*Id.* at 812.

First Amendment. For example, Andy Warhol's silkscreens, despite not obviously differing in their formal characteristics from Saderup's drawings, were transformative; this is essentially because Warhol was famous and therefore the art world reacted as if the silkscreens commented on the celebrities depicted, reactions the court attributed to Warhol's "distortion" and "careful manipulation of context."⁶⁴

As the court's blessing of Warhol indicates, using transformativeness to draw the line between protected and unprotected artistic works creates significant problems.⁶⁵ The choice of Warhol as a representative non-infringing artist is at best ironic, given Warhol's lack of involvement in many of "his" artworks and his explicit rejection of a line between art and commerce.⁶⁶ But the California Supreme Court reacted to Warhol's reputation, not to the content of his work or its conditions of production. The transformation the court saw in Warhol's work, but not in Saderup's mere craftsmanship, demonstrates that "visual perception depends not only on what something looks like, but also on what it means."⁶⁷ Transformativeness thus forces judges to become art critics and evaluate whose message matters.⁶⁸

This problem can be further illustrated by an example from renowned comics artist Brian Michael Bendis. Bendis created a portrait of Woody Allen, who has litigated and won some significant right of publicity cases.⁶⁹ This is a standard portrait, done in charcoal, that seems

⁶⁴*Comedy III* 21 P.3d. at 811.

⁶⁵See Bruce P. Keller & Rebecca Tushnet, *Even More Parodic Than the Real Thing: Parody Lawsuits Revisited*, 94 TRADEMARK REP. 979, 1014 (2004) ("Even accepting the idea that Warhol's cachet added value to his lithographs beyond the celebrity image portrayed, it is manifest that Saderup's cachet, though more limited, did so as well. . . . Under *Saderup*, traditional portraitists, photographers and likely the unknown Warhols and Lichtensteins of the next generation will be barred from using images free to looser hands." (footnote omitted)); cf. David Tan, *What Do Judges Know About Contemporary Art?: Richard Prince and Reimagining the Fair Use Test in Copyright Law*, 16 MEDIA & ARTS L. REV. 381 (2011) ("From the US state district courts all the way to the Supreme Court, judges are struggling to agree on what is worth protecting, but there seems to be an eerie unanimity that Andy Warhol's multiple silkscreen renditions that appropriate the image of Marilyn Monroe is the paradigmatic example of transformation in contemporary art that would qualify as fair use in copyright law.").

⁶⁶See ANDY WARHOL, *THE PHILOSOPHY OF ANDY WARHOL* 92 (1975) ("Being good in business is the most fascinating kind of art."); Gareth S. Lacy, *Standardizing Warhol: Antitrust Liability for Denying the Authenticity of Artwork*, 6 WASH. J.L. TECH. & ARTS 185, 186–87 (2011) ("In 1962, Andy Warhol began mass-producing silkscreened prints of Coke bottles, soup cans, and movie stars. Warhol produced this art in his studio, known as The Factory, in much the same way corporations mass-produced consumer goods. The line between business and art soon blurred for Warhol: 'Business art is the step that comes after Art. I started as a commercial artist, and I want to finish as a business artist.'" (citations omitted)).

⁶⁷Gary Lupyan & Michael J. Spivey, *Perceptual Processing Is Facilitated by Ascribing Meaning to Novel Stimuli*, 18 CURRENT BIOLOGY R410, R412 (2008).

⁶⁸Perceptions of what has been added to images are highly manipulable by context—a context that lawyers are happy to provide once litigation begins, adding to the problems of predictability and overreach. See Tushnet, *supra* note **Error! Bookmark not defined.**, at 733–38 (discussing "verbal overshadowing," in which verbal descriptions affect visual perception).

⁶⁹*Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360, 362, 371 (S.D.N.Y. 1988) (enjoining a look-alike's misappropriation of Woody Allen's persona); *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 630 (S.D.N.Y. 1985) (granting an injunction against a Woody Allen look-alike in a commercial); see also Complaint, *Allen v. Am. Apparel, Inc.*, No. 08 CV 3179, 2008 U.S. Dist. Ct. Pleadings LEXIS 9085 (S.D.N.Y. Mar. 31, 2008); Christopher Palmeri, *American Apparel Settles with Woody Allen*, BLOOMBERG BUSINESSWEEK (May 18, 2009), <http://perma.cc/C763-AFCK> (discussing the settlement of a claim based on two billboards featuring a photograph of Woody Allen).

therefore to fall right within the *Comedy III* boundaries for what violates the right of publicity in California.



The caption reads, “These portraits were something I did for myself; I do them when I am studying the artist’s work. Hard to explain how it helps me understand them, but it does.” Bendis makes a particular artistic claim: drawing Allen helps him understand Allen’s art.⁷⁰ Is this transformative, adding value beyond that of Allen’s own celebrity identity? If a court were to defer to this argument, it would have done so only because Bendis has used words to explain his visual art,⁷¹ and because a court proved willing to accept those words. Unlike copyright cases, where artists regularly get the chance to interpret their images, right of publicity cases demand that transformiveness be visually perceptible by judges, who are often not the audience to whom the relevant works are directed.⁷²

⁷⁰BRIAN MICHAEL BENDIS, *TOTAL SELL-OUT* (2003).

⁷¹Compare *Blanch v. Koons*, 396 F. Supp. 2d 476, 480–81 (S.D.N.Y. 2005), *aff’d*, 467 F.3d 244 (2d Cir. 2006), in which Jeff Koons’ testimony about the reasons he copied a fashion photograph explained transformiveness to the court in ways not obvious from the face of his painting. See Rebecca Tushnet, *Judges as Bad Reviewers: Fair Use and Epistemological Humility*, 25 *LAW & LIT.* 20, 22 (2013).

⁷²The benefit of relying on intentionalism—the meaning of works as explained by the artists themselves—is contestable, especially as the sole legitimate interpretive method. See, e.g., Monika Isia Jasiewicz, “A Dangerous Undertaking”: *The Problem of Intentionalism and Promise of Expert Testimony in Appropriation Art Infringement Cases*, 26 *YALE J.L. & HUMAN.* 143 (2014); Zahr Said, *Reforming Copyright Interpretation* (July 26, 2014) (unpublished manuscript), available at <http://perma.cc/6MPL-43NZ>. But right of publicity cases have yet to recognize that there are even interpretive choices to be made, and the easy “readability” or transparency of images likely contributes to that gap.

More generally, transformativeness is structurally biased in favor of text. A novel or nonfiction work about Marilyn Monroe that does not caricature her, but that seeks to represent her realistically, will still seem to many observers to involve more contribution by the artist than a picture of her, because the skill and creativity required for a visual artist to represent reality will be transparent—invisible as creative output—both to courts and to audiences, whereas the skill and creativity involved in writing a narrative will be obvious to them. Thus, the *Comedy III* test asks “whether the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.”⁷³ The California Supreme Court condemned “literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass,”⁷⁴ but did not notice that its use of “literal” really meant “visual.”

The *Comedy III* court was clear that artistic talent in the visual realm, if aimed at producing a realistic depiction, ought to be ignored in the transformativeness inquiry: “We ask . . . whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness. And when we use the word ‘expression,’ we mean expression of something other than the likeness of the celebrity.”⁷⁵ A “conventional portrait of a celebrity” is not protected against a right of publicity claim,⁷⁶ even though a “conventional” biography, reflecting reality in words, would plainly be protected by the First Amendment.

Here, concepts of realism play important roles: the word-portrait, however realistic in a literary sense, lacks direct correspondence to the celebrity, whereas the image’s transparency is more readily understood to mean that the image is nothing more than the celebrity. In essence, a realistic visual representation will be treated as just a copy of the celebrity presence itself—a kind of totem—whereas a verbal representation will never be conflated with the thing it represents. The *Comedy III* court implicitly denied the message of René Magritte’s famous painting, *The Treachery of Images*, in which a depiction of a pipe bears the caption, “This is not a pipe.” The court did not explain why some modes of realism should be more favored by the law than others, especially if both require the addition of creative “labor.”

Courts’ inability to see visual realism as an artistic choice leads them to conflate a representation with the thing represented.⁷⁷ This collapse between representation and reality in

⁷³*Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001).

⁷⁴*Id.* at 808.

⁷⁵*Id.* at 809.

⁷⁶*Id.* at 810; see also *id.* at 811 (finding that “literal, conventional depictions of the Three Stooges,” drawn in charcoal, make “no significant transformative or creative contribution”); *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981) (“[E]ntertainment that is merely a copy or imitation, even if skillfully and accurately carried out, does not really have its own creative component and does not have a significant value as pure entertainment.”).

⁷⁷See Tushnet, *supra* note **Error! Bookmark not defined.**, at 728 (discussing different concepts of realism); *id.* at 705 (“If you still doubt the power of the ‘magical relation between a picture and what it represents,’ try this experiment: take a picture of your mother and cut out the eyes. Images feel as if they have a mystic connection to the reality they represent, inducing in us the feeling that they will operate to cause harm at a distance.” (footnotes omitted)). Historically, our lore may have suggested that names have power; now, though, it is the face that matters.

images picks up on a problem that also arises with copyright's fair use doctrine, from which *Comedy III* drew its transformativeness test: to depict an image, one must depict the image.⁷⁸ There is no conventionally understood way to paraphrase an image, because to the extent that images are understood to share an external referent (such as a celebrity), they are the same. In *ETW Corp. v. Jireh Publishing, Inc.*, the court rejected a trademark claim by Tiger Woods against the creator of a painting depicting him as a hero of golf.⁷⁹ The majority held that Woods' own person was outside the scope of trademark law to the extent that Woods claimed to own a trademark in any image of himself, however angled or posed.⁸⁰ However, it could not reject the right of publicity claim on the same grounds, because that right *does* cover every image. All pictures of Tiger Woods are pictures of him; all pictures of the Three Stooges are pictures of them, even if they are posed in various ways. *Comedy III* itself involved a drawing that apparently had no precise photographic reference and that indeed somewhat heroicized the Stooges compared to the ways in which they were usually photographed, but the court still found against the artist because of the recognizable referent.

The difference between the expressive works protected by copyright and the personal identities protected by the right of publicity may help explain why the concept of transformativeness has been so flattened and misused in the latter body of law, while it has helped copyright fair use expand and accommodate many new, beneficial uses. In copyright cases, courts regularly identify transformation in *meaning* and *purpose*, not transformation in physical or visual presentation.⁸¹ In right of publicity cases, however, there is no specific allegedly-infringed work. Instead, courts have focused only on visual presentation or have made the wrong kinds of comparisons.⁸² Taking the copyright approach seriously would lead to very different outcomes: a creative work might well have the purpose "represent the celebrity," but that will always be a different purpose than "be the celebrity," which is the function of the celebrity's identity, even if both have monetary value.⁸³

⁷⁸See, e.g., *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006) (recognizing this necessity in the context of copyright fair use).

⁷⁹*ETW Corp. v. Jireh Publ'g, Inc.* 332 F.3d 915 (6th Cir. 2003).

⁸⁰*Id.* at 938.

⁸¹E.g., *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 97 (2d Cir. 2014); R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 COLUM. J.L. & ARTS 467 (2008).

⁸²For example, *Estate of Fuller v. Maxfield & Oberton Holdings, LLC*, 906 F. Supp. 2d 997 (N.D.Cal. 2012), rejected a First Amendment defense by the manufacturer of toys called "Buckyballs." The toys were so named because they could be manipulated to resemble a molecule commonly known as a "buckyball," named for Buckminster Fuller. *Id.* at 1002. The *Fuller* court held that transformativeness depended on the visual nature of the transformation, and that use of a name is not an act of expression the way creation or alteration of an image is. *Id.* at 1006. A name, it reasoned, can't be transformed while remaining recognizable, as an image can. *Id.* (Many a young victim of schoolyard taunting based on an unfortunately suggestive name might disagree with the factual premise.)

⁸³Of course, many celebrity identities are constructed, and celebrities are often performing particular versions of themselves. Whether those versions are "inauthentic" in some sense is irrelevant to this analysis, because even a performance of a constructed self is different from a representation of some other entity in the world, and thus would have a different "purpose" if courts truly used copyright's transformativeness test. Mark McKenna suggested to me that a real transformation of the celebrity's identity—the appropriate referent if there's no specific work at issue, as there is in a copyright case—would preclude a violation of the right of publicity in the first place, since a celebrity identity transformed would no longer be the celebrity. But since the right has expanded far enough to equate a robot in a blonde wig with Vanna White, see *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992), I'm not sure that formulation works.

In right of publicity cases comparing a celebrity identity to a work of art, the conceptual collapse between representation and reality has thus prevented coherent analysis of transformativeness. This slippage between the visual signifier and the signified in legal and non-legal thinking is fairly common,⁸⁴ but presents serious difficulties when First Amendment rights are implicated, not least because the First Amendment covers speech (representation of a celebrity) but not conduct (being a celebrity).

Where this identity between representation and reality breaks down, the law's treatment is also revealing. Courts will occasionally find enough distance from realism to identify visual transformativeness.⁸⁵ Returning to *Winter*, the post-*Comedy III* case in which the California Supreme Court easily found transformativeness, the court emphasized how different the comic's fantastic setting and the Autumn brothers' monstrous heritage was from the actual lives of musical performers Johnny and Edgar Winter.⁸⁶ Likewise, the Tenth Circuit found that caricatures of baseball players did not infringe the right of publicity because they commented critically on the baseball players they mocked.⁸⁷ Caricature distorts—exaggerates for critical effect—and thus is transformative.

When the Ninth Circuit held that a greeting card making fun of Paris Hilton created a factual issue of infringement,⁸⁸ it may therefore have been significant that the card used a photo rather than a drawing to show her face, while the rest of the card was drawn in an unrealistic comic style (though the court didn't say this explicitly):

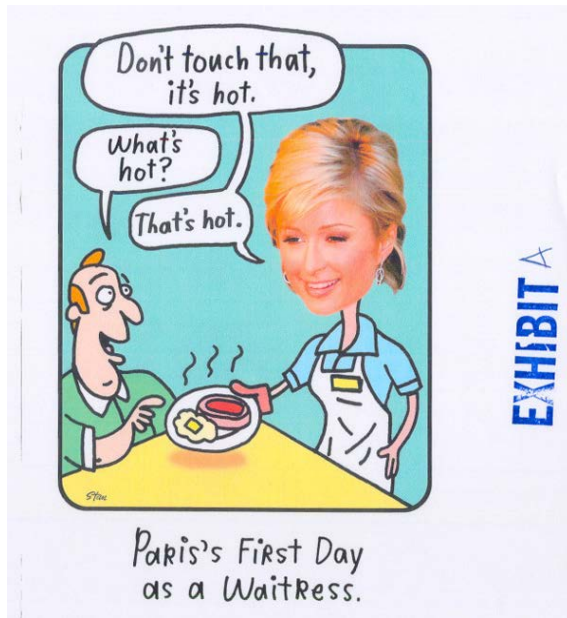
⁸⁴See, e.g., Dessa, *Camera Obscura*, in SPIRAL BOUND 59, 63–64 (2009) (“[O]nly the most recent generations have been confronted with images—still and moving—of their dead. These images invest the dead with just as much vivacity as we possess ourselves. There is Valentino lighting his cigarette, tapping it twice against the case. There he is bare-chested, in a rage. And there is smirking Valentino preparing to seduce the dancing girl—all the while completely unaware that he is dead . . . [P]eople with muscular forearms, people with tans, people who can arch one eyebrow in perfect isolation, people with really good comic timing, these are individuals with appetite. These are real people, like me and my friends.”).

⁸⁵*Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003).

⁸⁶*Id.* at 479.

⁸⁷*Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996).

⁸⁸*Hilton v. Hallmark Cards*, 599 F.3d 894, 910 (9th Cir. 2010) (“[I]t is clear that merely merchandising a celebrity’s image without that person’s consent, the prevention of which is the core of the right of publicity, does not amount to a transformative use.”); see also *No Doubt v. Activision Publ’g, Inc.*, 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011) (holding that it was not transformative to place visually accurate representations of members of a band in impossible physical locations or to have those representations perform songs the real band members would never perform, because the game avatars “remain at all times immutable images of the real celebrity musicians” and were “exact depictions of No Doubt’s members doing exactly what they do as celebrities”; distinguishing a previous case in which a video game character’s “physique, primary hairstyle and costumes, and dance moves” differed from the plaintiff’s and thus the character was found to be transformative).



What emerges from the case law is not inconsistency. It is bias against the visual. Others have rightly criticized the *Comedy III* court for overemphasizing visible changes at the expense of changes in meaning and context, which should also be considered transformative.⁹⁰ But it turns out that visible changes aren't even necessary—instead, the *absence* of a realistic visual representation in a defendant's creative work seems to be the most important feature of transformativeness and thus First Amendment protection (a pattern that continues in the video game cases discussed in the next Part).⁹¹ For example, one court was perfectly content to find transformativeness in the output of a rapper performing as Rick Ross, who copied the persona of actual convicted drug dealer Rick Ross.⁹² The music was analogous to a fictional work with a protagonist resembling the original Rick Ross; the rapper had created a “larger story” that made his music and persona “much more than literal depictions of the real Rick Ross.”⁹³

A focus on visual change risks holding realistic images infringing even when they are incorporated into political or cultural commentary—for example, a political advertisement featuring Lindsay Lohan's mug shot as part of an argument about alcohol-detecting ignition locks on cars.

⁸⁹See *Paris Hilton Sues Over Hallmark Card*, THE SMOKING GUN (Sept. 7, 2007), <http://perma.cc/Z2TY-5266>.


⁹⁰See, e.g., Dougherty, *supra* note **Error! Bookmark not defined.**, at 46–47 (criticizing *Comedy III*'s discrimination against realism); David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1, 27 (2011) (criticizing *Comedy III*'s apparent focus on the visual and lack of clarity on the roles of context and meaning).

⁹¹See also *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007); *cf.* *Toffoloni v. LFP Publ'g Grp., LLC*, 572 F.3d 1201 (11th Cir. 2009) (upholding publicity claim based on photos but not text of story about subject); *MPS Entm't, LLC v. Abercrombie & Fitch Stores, Inc.*, No. 11-24110-CIV, 2013 WL 3288039 (S.D. Fla. June 28, 2013) (finding no right of publicity claim where press release used subject's name but not his photograph).


⁹²*Ross v. Roberts*, 166 Cal. Rptr. 3d 359 (Cal. Ct. App. 2013).

⁹³*Id.* at 369.

Ignition interlocks
A good idea for:



But a bad idea for us:



Mag. shot of Lindsay Lohan, inserted for example only.

Ignition interlocks, or in-car breathalyzers, are a great tool for getting hard-core drunk drivers off our roads. However, activists now want to put one in every car in America. That means the end of moderate and responsible drinking prior to driving...No more champagne toasts at weddings, no more wine with dinner, no more beers at a ballgame. Let's stop drunk driving without eliminating our traditions.

Drink Responsibly.
Drive Responsibly.

Visit InterLockFacts.com

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In what sense does this advertisement differ from the Hallmark card featuring Paris Hilton's face surrounded by added creative content making reference to a catchphrase for which Hilton is well known, which the Ninth Circuit found potentially infringing? The ad does not transform Lohan's *image*, though it does make reference to an event for which Lohan is well known. Moreover, if the ad only used Lohan's name—"Ignition locks are appropriate for known drunk drivers like Lindsay Lohan, but not for all of us"—it's very hard to imagine a right of publicity claim succeeding, despite the failure to "transform" the name.

One possible response is that the American Beverage Association's political message deserves protection even absent transformativeness—the message "Ignition locks should only be mandated for serious drunk drivers" is sufficiently important that use of Lohan's image to attract attention should be allowed, whereas "It would be funny if Paris Hilton worked as a waitress" is of less significance. This distinction would push against the modern trend of First Amendment jurisprudence, which usually protects culture as well as overt politics,⁹⁵ and would require courts to figure out what counts as political speech, but it could be made. Such a solution would nonetheless highlight the insufficiency of transformativeness as a standard for protecting noncommercial speech. Absent a more robust theory of the proper scope of Lohan's right, distinctions of this sort will inevitably be ad hoc.

Transformativeness as it has been interpreted in right of publicity cases therefore has a chilling effect on any artist who wishes to work, at least in part, in a mode of visual realism. As

⁹⁴Castina W., *USA Today Lindsay Lohan Ignition Interlock Ad*, POPCRUNCH (May 2, 2008), <http://perma.cc/SJ3-DTQH>.

⁹⁵See *United States v. Stevens*, 559 U.S. 460 (2010).

a First Amendment boundary to the right of publicity, transformativeness is inadequate, wrongheaded, and discriminatory; it should be abandoned rather than reformed.

The problem is not limited to comics. As the next Part will show, when it comes to video games, courts have been increasingly overt in holding that realistic representations—*when those representations are visual*—can be controlled by celebrities. Following a familiar pattern,⁹⁶ courts don't seem to grant the comparatively new medium of video games full First Amendment protection. Although it's beyond the scope of this article, I speculate that video games make courts uneasy because of their liminality. Whereas comic books straddle the line between word and image, video games are somewhere between watching and doing, spectatorship and performance; this can make them analytically slippery.⁹⁷ If that's so, then, just as with comics, the passage of time may not be enough to guarantee equal dignity for First Amendment purposes, as it ultimately was for radio and movies.

III. Beyond Fake: Video Games and the Next Wave of Medium Discrimination

Video games have brought the transformativeness test to its breaking point. A game that shows a person in a context similar to that which brought him or her fame is likely to be deemed nontransformative and thus a violation of the right of publicity. The core problem with this conclusion is that it violates what would seem to be a simple syllogism: (1) realistic non-advertising fiction and nonfiction about celebrities is outside the scope of the right because of free speech limits;⁹⁸ (2) video games are a First Amendment-protected genre of expression, just like textual works;⁹⁹ therefore (3) a realistic non-advertising video game should be outside the constitutional reach of the right of publicity as well. One can imagine constitutional epicycles that would allow courts to distinguish a video game in which the player's acts can change the outcomes from both straight biography and from Joyce Carol Oates-style roman à clef. But courts simply haven't put in the work to attempt such distinctions, relying instead on appeals to "realism" that assume that only visual representations are realistic and ignore existing First Amendment protections for news photography and biographical illustration.¹⁰⁰

The representation/reality collapse apparent in *Comedy III*'s devaluation of realistic images appears again in the video game cases. In this model, unauthorized visual uses seem like involuntary servitude.¹⁰¹ In a particularly revealing comment, an early and influential

⁹⁶See RANDALL P. BEZANSON, ART AND FREEDOM OF SPEECH 1 (2009) ("[W]ith newly emerging aural and visual technologies, the U.S. Supreme Court has most often declined to apply the full force of constitutional protection, at least for a time, proceeding cautiously and in small steps with the mediums of radio, television, and film, and, most recently, electronic forms of communication. The Court's caution has been particularly evident with the more artistic and emotionally powerful genres of expression such as dance, film, or video."). Notably, the Supreme Court has recognized full First Amendment protection for video games; here it is the lower courts that lag behind.

⁹⁷See, e.g., DEREK A. BURRILL, DIE TRYIN': VIDEOGAMES, MASCULINITY, CULTURE 5, 45 (2008) (noting the ways in which video games confound the spectator/performer distinction).

⁹⁸See, e.g., *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P. 3d 797, 809 (Cal. 2001) ("[T]he transformative elements or creative contributions that require First Amendment protection . . . can take many forms, from factual reporting to fictionalized portrayal, from heavy-handed lampooning to subtle social criticism.") (citations omitted).

⁹⁹*Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729 (2011).

¹⁰⁰See *supra* note 31.

¹⁰¹See, e.g., *Pavesich v. New Eng. Life Ins. Co.*, 50 S.E. 68, 80 (Ga. 1905) (holding that a person whose image was used in advertising without his consent would conclude that "his liberty has been taken away from him; and, as long

photography case worried over “the humiliation and mortification of having [a man’s] picture displayed in places where he would never go to be gazed upon, at times when and under circumstances where if he were personally present the sensibilities of his nature would be severely shocked.”¹⁰² I’d be shocked to find myself in the bedroom with my favorite author, and I’m sure vice versa, but we don’t generally think there’s something disturbing about reading in bed. In the court’s imagination, however, the inert image seems to be looking out into the world in a magical way.

The judges in a recent video game case picked up on this theme during oral argument, invoking the specter of Elvis and Sean Connery being forced to perform via hologram when asking if video game companies were free to make realistic visual representations of people.¹⁰³ These questions evidenced the judges’ conflation of an image with what it represents. Elvis and Sean Connery *cannot* be forced to perform by illustrators and programmers, any more than they can be mutilated or spindled by mistreating posters of them. Although the judges would recognize that this is true, put in those exact terms, and though they would likely defend their terminology as mere shorthand, the compelling power of the image helps ease the way to finding that people should control their own images just as they control their own bodies.

One might argue that the judges were merely recognizing audiences’ likely reaction—audiences might feel that Elvis and Sean Connery were really present¹⁰⁴—but why that audience perception would inflict constitutionally cognizable harm is still a mystery. Suppose audiences did come to feel, at least subconsciously, that Richard Nixon actually shook hands with the fictional Forrest Gump. Under current law, that can’t count as actionable harm to Nixon because mere untruths that don’t hurt a person’s reputation can’t be defamatory.¹⁰⁵ Moreover, since the deceived audiences argument is an empirical claim about how people react to images, one would expect it to also be available to plaintiffs portrayed in text, if they could meet their burden of proof. But it’s not; only images trigger this “forced labor” reasoning.

Ultimately, the “involuntary servitude” concept helps extend the publicity right past the advertising uses that raise traditional false endorsement concerns. After all, if the image is essentially the same as the person depicted, being enslaved to a director making a feature film

as the advertiser uses him for these purposes, he cannot be otherwise than conscious of the fact that he is for the time being under the control of another, that he is no longer free, and that he is in reality a slave, without hope of freedom, held to service by a merciless master”); 1 MCCARTHY, *supra* note 2, § 2:5; Leslie A. Kurtz, *Fictional Characters and Real People*, 51 U. LOUISVILLE L. REV. 435, 461 (2013) (“When someone’s name and image is used by another in advertising, for example, some aspect of that person is under someone else’s control. It is a form of virtual involuntary servitude, of compelled speech. . . . [U]se without permission can be offensive to personal autonomy and human dignity, particularly if our *surrogate selves* are out there doing things we would not choose to do, or if we are turned into commodities against our wills.” (footnote omitted and emphasis added)).

¹⁰²*Pavesich*, 50 S.E. at 80.

¹⁰³Oral Argument, *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013) (No. 09-566751), *available at* <http://perma.cc/5XB4-KNQB>.

¹⁰⁴*Cf.* M. Ryan Calo, *Against Notice Skepticism in Privacy (and Elsewhere)*, 87 NOTRE DAME L. REV. 1027, 1039–40 (2012) (discussing evidence that people react to pictures of eyes similarly to being actually watched).

¹⁰⁵*See, e.g.,* *Richie v. Paramount Pictures Corp.*, 544 N.W.2d 21, 28 (Minn.1996) (stating general rule that defamation requires harm to reputation, although such harm may be presumed from certain accusations).

isn't obviously different from being enslaved to a director making a thirty-second ad.¹⁰⁶ Following this logic, courts have allocated control over images to their referents in most of the video game cases.¹⁰⁷ This Part summarizes a few key cases, reserving the most extensive discussion for *Hart v. Electronic Arts*, the first federal appellate case on the matter.¹⁰⁸

In *No Doubt v. Activision Publishing*, a California court found a violation of the right of publicity when the video game at issue used “immutable” images of the “real” musicians in the band No Doubt and didn't transform their context, instead having them perform rock songs as they did in life.¹⁰⁹ Even though the avatars could be manipulated to perform at fanciful venues or to sing songs the real band wouldn't ever sing, and even though the game had many other creative elements, the avatars were still “exact depictions” of the musicians doing what had made them famous: performing music. The use of highly realistic digital depictions “was motivated by a desire to capitalize on the band's fan-base,” so there was a violation of the right of publicity.¹¹⁰ This result can be compared to a hypothetical biography that is exact in every description and detail, the realism of which would plainly fail to justify liability. (*No Doubt* was complicated by the presence of a contract denying the game company the right to make these changes, but the court nonetheless found an independent violation of the right of publicity.¹¹¹)

In another California case, by contrast, the surrounding context was held to be transformative of the persona.¹¹² Ulala, a character in a futuristic video game, had many similarities to the performance identity of singer Lady Miss Kier: in the plaintiff's words, they shared “distinctive make-up, large eyelashes, doe eyes, red/pink hair, pony tails, cute backpacks, mini-skirts, knee-socks, knee-high boots, and platform shoes,” and Ulala's name allegedly sounded like one of Lady Miss Kier's ululations.¹¹³

¹⁰⁶See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1290 (9th Cir. 2013) (Thomas, J., dissenting) (making this point with reference to *Forrest Gump* and *Midnight in Paris*, both movies that fictionalize real historical figures). *Pavesich*, the judicial popularizer of the slavery trope, takes care to suggest that use of pictures in articles that are actually about a person are probably also subject to the new right the court is recognizing. 50 S.E. at 81. By contrast, Leslie Kurtz contends that recreations of an actor's appearance and performance in non-advertising works don't implicate the same personhood interests as ads do, but doesn't explain why not. Kurtz, *supra* note 101, at 464–65. Later, she argues that digital creation of a living actor, even in non-advertising works, *would* implicate those personhood interests as long as it is the actor, rather than a character previously portrayed by the actor, being represented. *Id.* at 478–79. I find this distinction too evanescent. As long as we recognize the actors, they are as present, and as forced to work for an unwanted master, when “they” appear in character as they are when “they” appear as themselves—not at all.

¹⁰⁷See William K. Ford & Raizel Liebler, *supra* note 23, at 4.

¹⁰⁸See *Hart v. Electronic Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013).

¹⁰⁹*No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011).

¹¹⁰*Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 162 (3d Cir. 2013) (citing *No Doubt*, 122 Cal. Rptr. 3d at 397).

¹¹¹*No Doubt*, 122 Cal. Rptr. 3d at 405.

¹¹²*Kirby v. Sega of America, Inc.*, 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006).

¹¹³Second Amended Complaint, *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006) (No. BC 294679), 2004 WL 5564733.



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The *Kirby* court held that the game context—in which Ulala was “a space age reporter in the 25th century,” not a singer like the plaintiff—was transformative of Kier’s identity.¹¹⁶ Sega seemed to have copied her signature phrases, hairstyle and clothing choice, but differences in appearances and movement also existed. As in the *Winter* comic case discussed in Part II, this additional new expression, departing from realism, was enough to be transformative, even without a particular meaning or message.¹¹⁷

The Third Circuit then entered the fray with *Hart v. Electronic Arts*.¹¹⁸ Hart, a former Rutgers football player, sued over Electronic Art’s (EA’s) use of his likeness and biographical information (size, weight, jersey number, typical attire of visor and armband) in its *NCAA Football* video games, as well as its use of his photo in a photo montage only visible when players selected Rutgers as their team. *NCAA Football* allows users “to experience the excitement and challenge of college football” by interacting with “over 100 virtual teams and thousands of virtual players.”¹¹⁹ The district court found that EA’s use was protected by the First Amendment, but the court of appeals reversed. The court emphasized that the game’s success depended on its focus on realism and detail, “from realistic sounds, to game mechanics, to team mascots.”¹²⁰

The court of appeals began by acknowledging that video games are fully protected by the First Amendment.¹²¹ However, such protection can be trumped by other rights; Hart’s right of publicity had to be balanced with the interests underlying the right to free expression.¹²² But the court did not actually weigh one interest against the other to determine which was stronger. That failure is not surprising since it’s not clear what “weight” really means when it comes to the competing values of rewarding celebrities with control over images and allowing artists to depict the world. Rather, the court engaged in a somewhat different project of delineating which

¹¹⁴*Ulala.jpg*, WIKIA SEGA FORUMS, <http://perma.cc/UKM5-RPEC> (last visited Oct. 19, 2014).

¹¹⁵Miss Lady Kier, 1994, FACEBOOK, <http://perma.cc/D776-LNS4?type=image> (last visited Oct. 19, 2014).

¹¹⁶*Kirby*, 50 Cal. Rptr. 3d at 618.

¹¹⁷*See supra* notes 58, 85–86 and accompanying text.

¹¹⁸*Hart v. Electronic Arts, Inc.*, 717 F.3d 141, 146 (3d Cir. 2013).

¹¹⁹*Id.*

¹²⁰*Id.*

¹²¹*Id.* at 148 (citing *Brown v. Entm’t Merchs. Ass’n*, 131 S. Ct. 2729, 2733 (2011)).

¹²²*Id.* at 149–50 (citing *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977), and *Eldred v. Ashcroft*, 537 U.S. 186 (2003)).

expressive works would be protected against liability despite seeking commercial advantage from use of a celebrity's identity.

The court accepted a property theory of the right of publicity: people's names and likenesses belong to them as property because they are things of value. Unauthorized use therefore harms the victim by "diluting the value of the name and depriving that individual of compensation."¹²³ The purpose of the right of publicity is to protect an individual's property interest in an identity gained through labor and effort, and to encourage further investment in this property interest.¹²⁴

The *Hart* court identified three approaches to First Amendment limits on the right: the *Doe v. TCI* "predominant use" test, the trademark-based *Rogers* test that asks whether a use is artistically relevant to the user's work, and the copyright-based transformative use test of *Comedy III*. The Third Circuit noted that the *Doe* test, asking whether the predominant use of a celebrity's identity is commercial, is "subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics. These two roles cannot co-exist."¹²⁵ The court declined to delve into whether using Hart's identity added anything to the "First Amendment expressiveness" of EA's game as a whole:

Such reasoning . . . leads down a dangerous and rightly-shunned road: adopting [*Doe*] would be tantamount to admitting that it is proper for courts to analyze select elements of a work to determine how much they contribute to the entire work's expressiveness. Moreover, as a necessary (and insidious) consequence, the [*Doe*] approach would suppose that there exists a broad range of seemingly expressive speech that has no First Amendment value.¹²⁶

The second option, the *Rogers* rule, takes its name from a Second Circuit case involving a Fellini movie, *Ginger and Fred*. This movie told the story of two Italian dancers who emulated Ginger Rogers and Fred Astaire and were known, in the fictional world of the film, by those nicknames.¹²⁷ Ginger Rogers sued for trademark infringement and for violation of her right to publicity. The Second Circuit, citing First Amendment concerns, set forth a rule that the use of a mark (or celebrity name) in a title would not be actionable under either head of liability unless the mark either: (1) lacked artistic relevance to the work or (2) was explicitly misleading about the source (e.g., an "Official Ginger Rogers Cookbook" not endorsed by Rogers).¹²⁸

The *Hart* court rejected *Rogers* because it would "potentially immunize a broad swath of tortious activity."¹²⁹ Though *Rogers* might be useful in "trademark-like right of publicity cases"

¹²³*Id.* at 151 (quoting *McFarland v. Miller*, 14 F.3d 912, 919, 923 (3d Cir. 1994)).

¹²⁴*Id.* (citing *Zacchini*, 433 U.S. at 573 ("[T]he State's interest in permitting a 'right of publicity' . . . is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors . . .")).

¹²⁵*Id.* at 154.

¹²⁶*Id.*

¹²⁷*Rogers v. Grimaldi*, 875 F.2d 994, 996–97 (2d Cir. 1989).

¹²⁸*Id.* at 999.

¹²⁹*Hart*, 717 F.3d at 155. At the same time, the court noted that the *Restatement (Third) of Unfair Competition* restricts the right of publicity to "use for purposes of trade," which does not "ordinarily include the use of a person's

(whatever that might mean),¹³⁰ the court found it inappropriate in the case at bar, because *Rogers* was a “blunt instrument” that didn’t carefully calibrate the “balancing of two fundamental protections: the right of free expression and the right to control, manage, and profit from one’s own identity.”¹³¹ The court failed to explain why the right of publicity as applied to noncommercial speech was a *fundamental* right, or why categorical balancing would be inappropriate. Categorical balancing is often used in First Amendment cases,¹³² and one major reason is to avoid chilling effects¹³³—after all, case-by-case determination of transformativeness has significant costs for risk-averse creators that should be taken into account in any “balancing” endeavor.

The real problem, the *Hart* court wrote, was that applying *Rogers* would let EA win. Hart’s likeness and biographical data were, essentially by definition, relevant to a game about NCAA football. To the court, “[a]dopting this line of reasoning threatens to turn the right of publicity on its head.”¹³⁴ The target audience for Hart’s “merchandise and performances” would be sports fans, so products “appropriating and exploiting his identity” would do best with them.¹³⁵ But under *Rogers*, all products (including, in this reasoning, all noncommercial speech) targeting the sports fan market would, as a matter of course, relate to Hart and fall outside his right of publicity. This, the *Hart* court reasoned, couldn’t possibly be right.

Consider how these statements would apply to a conventional print biography of Hart. Would denying Hart control over such a biography “turn the right of publicity on its head”?¹³⁶ What about a photograph accompanying a news story about the Rutgers football team?¹³⁷ What

identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses” unless a name or likeness is used solely to attract attention to an unrelated work. *Id.* at 156. The *Restatement* specifically mentions uses in articles in fan magazines, feature stories on entertainment programs, unauthorized biographies, novels, plays and motion pictures. *Id.* (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995)). This treatment is puzzling at best—the court seemed to suggest that rejecting *Rogers* wouldn’t cause trouble for any of these kinds of expression since they wouldn’t ordinarily be within the scope of the right of publicity anyway—but it never explained why a video game then *would* be, or why *Rogers* would exempt too many works from the scope of the right of publicity if most expressive works weren’t covered anyway. The impression is of a rule constructed just to sweep in video games and visual art.

¹³⁰*Hart*, 717 F.3d at 157. The court might have meant “ordinary advertising cases,” though that doesn’t make much sense of *Rogers*, a movie title case. It might have meant “cases in which the celebrity also alleges confusion over endorsement,” though celebrities routinely bring both trademark and right of publicity claims, and it also is hard to understand why the legal standard for one claim ought to change depending on what other independent claims are alleged along with it.

¹³¹*Hart*, 717 F.3d at 157.

¹³²*See, e.g.,* Mark Tushnet, *Heller and the Perils of Compromise*, 13 LEWIS & CLARK L. REV. 419, 424–25 (2009).

¹³³*See* Melville B. Nimmer, *The Right to Speak from Times to Time: First Amendment Theory Applied to Libel and Misapplied to Privacy*, 56 CAL. L. REV. 935, 942–43 (1968).

¹³⁴*Hart*, 717 F.3d at 157.

¹³⁵*Id.* at 157–58.

¹³⁶*Cf. White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting from denial of reh’g en banc) (“Intellectual property rights aren’t like some constitutional rights, absolute guarantees protected against all kinds of interference, subtle as well as blatant. They cast no penumbras, emit no emanations: The very point of intellectual property laws is that they protect only against certain specific kinds of appropriation.” (footnote omitted)).

¹³⁷*Cf. Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639 (Cal. App. 1995) (holding that “full page newspaper accounts” of Super Bowls, featuring photographs of the star quarterback Joe Montana, were protected despite the photos’ use to sell newspapers).

about Joyce Carol Oates' next roman à clef about a college football player who sues a video game company? All of these would find likely audiences among football fans. The court asserted that "[i]t cannot be that the very activity by which [Hart] achieved his renown now prevents him from protecting his hard-won celebrity."¹³⁸ But this statement begged the question of what "protecting" that celebrity could constitutionally mean: it could readily be the case that *engaging in noncommercial speech* about the very activity by which Hart achieved his renown prevents him from maintaining a successful claim against the speakers. Compare the famous Obama "Hope" poster: It too was an unauthorized use of the subject's image, used in the context of "the very activity by which [Obama] achieved his renown," in this instance politics. Moreover, candidate Obama really did strike optimistic, inspiring, presidential poses, as he did in the photo on which the poster was based.

Having rejected *Rogers*, the *Hart* court went on to endorse the observation in *Rogers* that the right of publicity doesn't have consumer confusion as an element and is therefore "potentially broader" than trademark.¹³⁹ Yet this is a reason why the right of publicity should do *less well* in any balancing test than trademark¹⁴⁰—a regulation of deceptive speech is more likely to be constitutional than a regulation of non-deceptive speech.¹⁴¹ A right of publicity claim shouldn't trump freedom of speech when an equivalent trademark claim, supposedly protecting *both* the public and the trademark owner, wouldn't be sufficiently weighty to do so. Instead, the *Hart* court tautologically reasoned that the right of publicity was more important because it allowed the celebrity to control more: "[T]he right of publicity is broader and, by extension, protects a greater swath of property interests. Thus, it would be unwise for us to adopt a test that hews so closely to traditional trademark principles."¹⁴²

The *Hart* court therefore turned to a "broader, more nuanced test," transformative use.¹⁴³ Unlike the artistic relevance test of *Rogers*, transformativeness allows courts "to account for the fact that misappropriation can occur in any market segment, including those related to the celebrity."¹⁴⁴ The right of publicity, like copyright, applies to noncommercial speech, and as with copyright fair use, transformative uses are less likely to interfere with the owner's economic

¹³⁸*Hart*, 717 F.3d at 158.

¹³⁹*Id.* (citing *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989)).

¹⁴⁰*See* *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003) (discussing First Amendment risks of non-confusion-based liability); *cf.* Zimmerman, *supra* note **Error! Bookmark not defined.**, at 74–75 (observing that reputation, privacy and similar interests are rarely sufficient to justify overriding First Amendment rights to engage in noncommercial speech).

¹⁴¹*See* *Bartnicki v. Vopper*, 532 U.S. 514, 527 (2001) ("As a general matter, 'state action to punish the publication of truthful information seldom can satisfy constitutional standards.'" (quoting *Smith v. Daily Mail Publ'g Co.*, 443 U.S. 97, 102 (1979))). By contrast, deceptive speech can be punished in a number of circumstances, at least when it causes harm. *See* *United States v. Alvarez*, 132 S. Ct. 2537 (2012).

¹⁴²*Hart*, 717 F.3d at 158. Traditional pre-*Sullivan* defamation law protected a greater swath of personality interests than current defamation law; that made it unconstitutional. *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964). And one could say, as Justice Stevens once did, that the U.S. flag is the "property" of the American people, and yet flag burning statutes are still unconstitutional. *See* *United States v. Eichman*, 496 U.S. 310, 323 (1990) (Stevens, J., dissenting). Calling an interest "property" doesn't make it First Amendment-immune. Even the cases upholding expansion of the copyright term and restoration of expired foreign copyrights don't go that far. *See* *Golan v. Holder*, 132 S. Ct. 873 (2012); *Eldred v. Ashcroft*, 537 U.S. 186 (2003). Nor has any legislature adopting a right of publicity engaged in even the token fact-finding backing up copyright term extension or restoration.

¹⁴³*Hart*, 717 F.3d at 158.

¹⁴⁴*Id.* at 163.

interests.¹⁴⁵ Transformativeness could include factual reporting and fictionalized portrayal along with parody and satire, though the court did not detail what was transformative about factual reporting. The inquiry, as *Comedy III* said, was “in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.”¹⁴⁶ The *Hart* court also did not explain what made this inquiry differ from the “judge as art critic” rule it rejected from *Doe*.¹⁴⁷ Quoting *Comedy III*, the court defined the question as whether the depiction of the celebrity “has become primarily the defendant’s own expression rather than the celebrity’s likeness,” and this “expression” must be “of something other than the likeness of the celebrity.”¹⁴⁸

Again, one might well wonder how biographies and news reporting meet this standard.¹⁴⁹ The key is the unacknowledged medium discrimination: word portraits will never be in jeopardy, because to judges, textual works will always seem to be “the [writer’s] own expression,” and images incidentally present in genres associated with writing, such as news and biography, will be protected by that association. Because the writer is seen as necessarily translating the world into another medium, and the creator of a visual depiction is not (again, the collapse between representation and reality), courts can say blatantly false things such as, “[E]ntertainment that is merely a copy or imitation, even if skillfully and accurately carried out, does not really have its own creative component and does not have a significant value as pure entertainment.”¹⁵⁰

These assertions about visual realism completely misconstrue how audiences create meaning. Players play video games rather than watching stock footage because the experiences

¹⁴⁵*Id.* at 159.

¹⁴⁶*Id.* (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.* 21 P.3d 797, 810 (Cal. 2001)).

¹⁴⁷*Id.* at 154. Later, the *Hart* court stated that, unlike the *Doe* test, transformativeness is “more circumscribed,” focusing on specific aspects of a work “that speak to whether it was merely created to exploit a celebrity’s likeness.” *Id.* at 163. Even if the celebrity identity has marketing power, that can be acceptable, as long as the “work is the creator’s own expression.” *Id.* It’s still hard to figure out how that differs from the *Doe* test of the “primary” value of the work coming from the celebrity, especially given that the *Hart* court ultimately held that *NCAA Football* wasn’t transformative and thus was “merely created to exploit” Hart’s likeness, despite all its other content. The *Hart* majority specifically ruled that it didn’t matter that Hart was a tiny part of the overall game. *Id.* Consideration of the other creative elements was improper, because transformativeness is about “how the celebrity’s identity is used in or is altered by other aspects of a work,” without consideration of “[w]holly unrelated elements.” *Id.* at 169. Consideration of the broader context of a work should be aimed at “whether this context acted upon the celebrity identity in a way that transformed it or imbued it with some added creativity beyond providing a ‘merely trivial variation.’” *Id.* (By this standard, *Forrest Gump* seems problematic, since celebrities appeared therein not to change viewers’ perceptions of the celebrity but to add meaning to Forrest Gump’s journey.)

¹⁴⁸*Id.* at 160.

¹⁴⁹Transformativeness was, in the *Hart* court’s view, consistent with the *Restatement (Third) of Unfair Competition*, followed by many jurisdictions in defining the scope of the right. *Id.* at 165 n.35. The examples that the *Restatement* comments list as protected against liability “all exemplify the sort of transformative uses that would generally pass the analysis set forth in *Comedy III*.” *Id.* Thus, “already-existing First Amendment protections in right of publicity cases apply to video games with the same force as to ‘biographies, documentaries, docudramas, and other expressive works depicting real-life figures.’” *Id.* at 165. Yet those categories are listed in the *Restatement* as examples of types of works that would not violate the right of publicity, while the *Hart* majority held that a video game does violate it, so the “same force” appears to operate differently on video games.

¹⁵⁰*Estate of Presley v. Russen*, 513 F. Supp. 1339, 1359 (D.N.J. 1981); see also *Hart*, 717 F.3d at 164 (where a work contains “‘merely a copy or imitation’ of the celebrity’s identity . . . there can be no First Amendment impediment to a right of publicity claim”).

are qualitatively different. People go to see impersonators instead of watching video of the original performer because the two experiences aren't substitutes. If the impersonator doesn't seem significant, consider the powerful real-world effect of Tina Fey's performance of Sarah Palin's exact words.¹⁵¹ To suggest that Fey's performance lacked "its own creative component" or "significant value" is hardly credible.

Hart had one final case to distinguish: *C.B.C. Distribution v. Major League Baseball Advanced Media*, which found that fantasy baseball leagues didn't violate the right of publicity when using real players' biographical data to construct imaginary leagues for players to "play."¹⁵² Fantasy baseball sounds very much like *NCAA Football*. But, implicitly admitting the medium discrimination at work, the *Hart* court stated that the baseball players' records were publicly available information and thus protected by the First Amendment. By contrast, "[t]he presence of a digital avatar that recreates Appellant in a digital medium differentiates this matter from *C.B.C.*"¹⁵³

But "the presence of a digital avatar" isn't a reason; it's a description. Indeed, to the extent that the court was suggesting that the video game did more than use publicly available information, it seems to be penalizing the *addition* of creative effort in programming visuals compared to the use of data in textual form, which is exactly the opposite of the idea that additional creative input is what limits the scope of the right of publicity. What remains unclear is *why* the use of a video simulation of Hart justifies his victory when the baseball players lost because game-makers only used nonvisual information. A case could be made to give celebrities greater rights in pictures than in anything else, and I'll take that case up below, but that's not what the court purports to be doing with its claim to apply the First Amendment with the "same force" to different media, while also maintaining that the right of publicity is a right to control the commercial appropriation of "identity."¹⁵⁴

The *Hart* majority found *NCAA Football* non-transformative because the game sought to create a realistic depiction of college football, including realistic representations of players, seeking to capitalize on the fan bases of teams and players. Recreating a likeness in a (visual) medium other than photographs or video can't in itself satisfy the transformativeness test, the

¹⁵¹See Rebecca Tushnet, *Performance Anxiety: Copyright Embodied and Disembodied*, 60 J. COPYRIGHT SOC'Y U.S.A. 209, 219 (2013).

¹⁵²*Hart*, 717 F.3d at 165 n.37 (citing *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007)).

¹⁵³*Id.* This distinction caused the court some uncertainty about the scope of its holding; having relied on the visual as the key determinant of infringement, it then worried about what would happen if the visual representation were not very good—suppose players were looking at vague colored blobs that happened to bear real players' names? "It remains an open question . . . whether right of publicity claims can extend into the bygone days of 8-bit graphics and pixilated representations." *Id.* at 166 n.38. Here, though, the digital avatar closely resembled the "genuine article" in hair color, hair style, skin tone, accessories, vital information and biographical details, and perfect realism wasn't required for infringement. *Id.* at 166.

¹⁵⁴*Id.* at 165, 169–70.

court reasoned, or the right of publicity would not extend as far as it should.¹⁵⁵ Digital Hart did what actual Hart did at Rutgers—“he”/he played football.¹⁵⁶

If realism prevents First Amendment protection, deposed Panamanian dictator Manuel Noriega might have a plausible right of publicity claim based on the appearance of a Noriega-like character in the war game *Call of Duty: Black Ops II*, performing violent acts similar to those that made Noriega notorious.¹⁵⁷ As one report explains:

In Activision’s video game, Noriega initially helps the CIA capture a Nicaraguan terrorist, but later turns on the Americans and is hunted himself. In reality, Noriega did work as a CIA informant before the agency broke ties with him. After the US became concerned about his violent rule, President George Bush ordered the invasion of Panama in 1989, which resulted in his capture.¹⁵⁸

It sounds as if “[t]he digital [Noriega] does what the actual [Noriega] did while [in Panama],”¹⁵⁹ even if the “plays” he made weren’t exactly the same. Under *Hart*, this verisimilitude signals a right of publicity violation, at least where the realism is contained in a video game.¹⁶⁰ Since the creativity added by the rest of the game outside of the avatar is to be disregarded in the *Hart* majority’s analysis of where the value in a video game comes from, Lindsay Lohan might even have a claim against *Grand Theft Auto V* for using a paparazzi-dodging actress type character that allegedly looks like her.¹⁶¹

Reinforcing the de facto separate treatment of video games and other media, the majority then held that the single actual photo of Hart at issue was not actionable. It was a component of a montage in the 2009 edition of the game, and was therefore transformative and protected by the First Amendment. Like the use of an image of Tiger Woods in a collage juxtaposing him with other golf greats,¹⁶² putting the photo in the context of a Rutgers montage “imbue[d] the *image* with additional meaning beyond simply being a representation of the player.”¹⁶³ (I add the emphasis to highlight the slippage between the celebrity and a particular image of the celebrity. The photo puts Hart in the context of the Rutgers team. According to the majority, that’s

¹⁵⁵*Id.* at 166 n.39.

¹⁵⁶*Id.* at 166. But again, this would also have been true of an unauthorized biography or docudrama; the court never explained why biographies are transformative, because that went without saying. See Ford & Liebler, *supra* note 23, at 88–89.

¹⁵⁷See Complaint, *Noriega v. Activision Blizzard Inc.*, No. BC-551747 (Cal. Super. Ct. July 15, 2014).

¹⁵⁸Leo Kelion, *Manuel Noriega Sues Activision over Call of Duty*, BBC NEWS (July 16, 2014), <http://perma.cc/3HEJ-NE39>.

¹⁵⁹*Hart*, 717 F.3d at 166.

¹⁶⁰The California Superior Court, holding that “the entirety of the disputed work should ... be considered” in transformativeness analysis, recently dismissed Noriega’s claim, reasoning that Noriega’s identity was only part of the “raw materials” from which the entire game was synthesized. *Noriega v. Activision/Blizzard Inc.*, No. BC-551747, slip. op. at 5 & n.4 (Cal. Super. Ct. Oct. 27, 2014).

¹⁶¹Joe Mullin, *Lindsay Lohan Sues Makers of GTA V over Look-Alike Complaints*, ARS TECHNICA (July 3, 2014), <http://perma.cc/QBW2-VRAV>.

¹⁶²*ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003). Perhaps revealingly, the *Hart* court misread *ETW*, describing the artwork at issue as a photographic collage, when in fact it was a painting. *Hart*, 717 F.3d at 161. For these purposes, apparently all images look alike.

¹⁶³*Hart*, 717 F.3d at 170 (emphasis added).

transformative. But the avatar, which plays on the digital Rutgers team and is thus always in the context of that team, is not.)

Judge Ambro dissented, agreeing that transformativeness was the proper test but interpreting and applying it differently. This disagreement itself adds credence to the objection that transformativeness requires judges to become art critics, especially in the context of the right of publicity where the question does not involve comparing two creative works and identifying their differences as it does in a copyright fair use analysis. Judge Ambro would have given weight to the fact that Hart's avatar was part of a much larger storyline involving plenty of creativity supplied by EA.¹⁶⁴

Following the syllogism that began this Part, Judge Ambro pointed out that the majority, despite its nods toward medium neutrality, failed to be neutral in its use of the test. "EA's use of real-life likenesses as 'characters' in its *NCAA Football* video game should be as protected as portrayals (fictional or nonfictional) of individuals in movies and books."¹⁶⁵ The use of realism to increase profits—which, in the majority's view, showed lack of transformativeness—could not remove First Amendment protection from a work.¹⁶⁶

A month later, the Ninth Circuit also held, using essentially identical reasoning to that of the *Hart* majority, that *NCAA Football* wasn't transformative.¹⁶⁷ On the same day, it held that EA's *Madden NFL* games were protected against Lanham Act false endorsement challenges because, under *Rogers*, their realism made the use of celebrity identities artistically relevant to the games.¹⁶⁸ The same realism that triggered First Amendment protection against the Lanham Act condemned EA's games under the right of publicity.¹⁶⁹ Of particular note, the Ninth Circuit agreed with the *Hart* majority that it was the visual element of the games that stripped them of

¹⁶⁴*Id.* at 171–173. As Judge Ambro elaborated, users who selected the 2005 Rutgers team (and didn't change the avatar's characteristics) would experience the numerous creative elements of the game as part of every fictional play. Thus, Hart's likeness was one of the raw materials from which a new work was synthesized, rather than the sum and substance of the work in question. *Id.* at 175.

¹⁶⁵*Id.* at 174.

¹⁶⁶"This approach is at odds with the First Amendment protection afforded to expressive works incorporating real-life figures. That protection does not depend on whether the characters are depicted realistically or whether their inclusion increases profits." *Id.* at 174.

¹⁶⁷*In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013).

¹⁶⁸*Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013). As it turns out, this speech-protective rule, which makes inquiry into actual consumer confusion unnecessary, might well accurately capture consumer perceptions. In a survey by authors whose discussion indicates support for the extension of the right of publicity to video games, only 10% of video game players believed that the athletes depicted were endorsing the games—a percentage low enough to indicate lack of likely confusion, especially given that this is a gross percentage and not a net percentage after controlling for misunderstanding and other forms of noise. See Galen Clavio, Anastasios Kaburakis, David A. Pierce, Patrick Walsh & Heather Lawrence, *College Athlete Representations in Sports Video Games*, 6 J. ISSUES INTERCOLLEGIATE ATHLETICS 57 (2013) (finding that 15% of respondents surveyed were uncertain about whether athletes were endorsing the video games and 10% thought they were doing so; "the more familiar a consumer was with the game, the less likely he/she was to believe the players are endorsing the products").

¹⁶⁹See *In re NCAA*, 724 F.3d at 1279. Trademark law has its own pathologies, but in expressive use trademark cases courts have paid more attention to First Amendment issues even with respect to images, possibly because courts at least think they know what trademark is for—unlike the even more amorphous right of publicity—and thus can better appreciate that trademark's consumer protection function doesn't require giving trademark owners control over noncommercial speech. See, e.g., *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003) (protecting artistic use of Barbie doll against Mattel's trademark and copyright claims).

the First Amendment protection otherwise available for the use of publicly available data such as players' statistics.¹⁷⁰

After these cases, we are left with a body of law out of step with the rest of First Amendment doctrine, which discriminates against visual realism for no articulated reason. Could such a reason be given? The next Part takes up that challenge.

III. Possible Justifications for Differential Treatment of Images

Even in restrictive states such as New York, the right of publicity, both in statutes and at common law, invariably covers both names and likenesses.¹⁷¹ In practice, however, that equality does not apply to noncommercial speech, where only images—or moving images—are actionable. Is this really medium discrimination? Or are courts recognizing that people process images differently than words, making use of an image relevantly different from use of a name? What's at stake in this determination is precisely what we think the First Amendment is for.

Why might a person's interest in controlling uses of her picture override another person's right to engage in noncommercial speech when an interest in controlling uses of her name would not? This argument could be framed in terms of impact, excess or harm. If a person's right of publicity interest increases because of the greater communicative impact of the image—whether rational or not—that usually is an unsound justification from a First Amendment perspective. Speakers generally have a strong free speech interest in choosing for themselves the most effective forms in which to disseminate their messages.¹⁷² Even advertisers have substantial freedom to choose non-deceptive, non-defamatory images with which to tout their products, because different visual images may communicate different things, affecting the advertiser's persuasive message.¹⁷³

One might argue that photographs (though not necessarily video game avatars) convey more information than words, which always fail to fully describe their subjects, and that this additional information is excessive and unnecessary.¹⁷⁴ While photographs leave plenty of detail

¹⁷⁰See, e.g., *In re NCAA*, 724 F.3d at 1283 n.12 (distinguishing the fantasy baseball protected in *C.B.C. Distribution*, because of the “big difference” created by the use of visual avatars, whereas fantasy baseball just used names, performance and biographical data).

¹⁷¹See 1 MCCARTHY, *supra* note 2, §6.8 (chart showing that every state statute protects name and likeness); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995) (defining common-law right to cover name and likeness). Many courts simply speak of “identity” when discussing the common-law right; I am unaware of any case that recognizes the right of publicity but refuses to protect a name or likeness that actually identifies the plaintiff.

¹⁷²See *Cohen v. California*, 403 U.S. 15, 25 (1971) (reversing conviction for disturbing the peace based on defendant's “Fuck the Draft” jacket, worn inside a courthouse, and noting “it is . . . often true that one man's vulgarity is another's lyric”).

¹⁷³See *Disc. Tobacco City & Lottery, Inc. v. United States*, 674 F.3d 509, 547–48 (6th Cir. 2012) (invalidating ban on use of color in most tobacco advertisements and noting color's use in, among other things, getting attention and conveying information).

¹⁷⁴See *Douglas v. Hello!, Ltd.*, [2007] UKHL 21 (H.L.) [326] (appeal taken from Eng.) (holding that wedding photos contained extra, protectable information beyond mere facts: “information as to how the wedding looked . . . bring the event to life and make the viewer a virtual spectator at it”); *Douglas v. Hello!, Ltd.*, [2005] EWCA (Civ) 595 [84] (photographs “are not merely a method of conveying information that is an alternative to verbal description. They enable the person viewing the photographs to act as a spectator, in some circumstances voyeur would be the more appropriate noun, of whatever it is that the photographs depict.”); Justin Hughes, *The Photographer's*

out as well, they may *seem* more complete, contributing to their greater impact.¹⁷⁵ Yet the First Amendment’s general solicitude for conveying (non-defamatory) information makes greater information content a reason to grant images more First Amendment protection, not less. If the theory is that an excess of visual information is less important than nonvisual information, that’s again usually a judgment that the First Amendment requires to be left to individual speakers.¹⁷⁶

If the rationale for disparate treatment is instead that the image does more *harm* than the use of the name,¹⁷⁷ we again have to ask why, especially when we are dealing with constructed images, such as those in video games, that cannot be taken to be “real” representations of what a person actually did but at most reconstructions or simulations. Though neither the name nor the image can actually be used to conjure with, the idea could be that the use of the image works a greater intrusion into the dignity of the person than mere use of a name.¹⁷⁸ But given First Amendment doctrine’s general tolerance for dignitary intrusions when the intrusions involve *falsity*, it seems hard to understand why the right of publicity would extend to non-false representations of publicly known facts, such as a person’s appearance or athletic record, even if the representations were experienced as loss of control. In other areas of law, public figures are required to grow thicker skins.

Finally, the idea might be that images are just more valuable and thus the celebrity loses more if she can’t control her image than if she can’t control her name in noncommercial speech.

Copyright—Photograph as Art, Photograph as Database, 25 HARV. J.L. & TECH 329, 337–38, (2012) (discussing English cases, which conceptualize privacy violations through photos as “the disclosure of detailed information”; the visceral nature of photos, he suggests, “is a function of the sheer amount of information the photo conveys” and “cannot be separated from it being an incredibly detailed database”).

¹⁷⁵See Tushnet, *supra* note **Error! Bookmark not defined.**, at 692–93; see also NEAL FEIGENSON & CHRISTINA SPIESEL, LAW ON DISPLAY 7–9 (Jack M. Balkin & Beth Simone Noveck eds., 1st ed. 2009) (discussing features of photographs that make them seem more complete and easy to understand than text); WILLIAM J. MITCHELL, THE RECONFIGURED EYE: VISUAL TRUTH IN THE POST PHOTOGRAPHIC ERA 40, 83–84, 192 (1992) (explaining how photography’s claims to truth are in fact dependent on context); Rudolf Arnheim, *The Images of Pictures and Words*, 2 WORD & IMAGE 306, 308–10 (1986) (distinguishing between what is depicted in a photo or film clip and what the depiction means).

¹⁷⁶See *W. Va. State Bd. of Educ. v. Barnette*, 319 U.S. 624, 632–33 (1943).

¹⁷⁷By comparison, consider the treatment of crime scene and autopsy photos, where the harm of unauthorized disclosure is not pecuniary but emotional distress to the families of the deceased. Some courts are willing to assume, in the course of freedom of information litigation, that autopsy and crime scene photographs are more distressing than words conveying the events or situations depicted in the photos. See, e.g., *State v. Rolling*, No. 91-3832 CF A, 1994 WL 722891, at *6 (Fla. Cir. Ct. 1994) (reasoning that photos could be withheld to protect family interests, in part because written documents could provide similar information to that contained in the photographs without causing the same distress); *Campus Commc’ns, Inc. v. Earnhardt*, 821 So. 2d 388, 392–93 (Fla. Dist. Ct. App. 2002) (same rationale); Megan Bittakis, *Tragic Representations: The Curious Contradiction Between Cases Seeking Access to Autopsy and Death Scene Photographs and Cases Regarding the Consequences of Such Photographs Being Published*, 40 N. KY. L. REV. 161 (2013). Other decisions, generally but not uniformly older, have equated the information in a crime scene photo to that in a written description. See, e.g., *Kelley v. Post Publ’g Co.*, 98 N.E.2d 286, 287 (Mass. 1951) (“A newspaper account or a radio broadcast setting forth in detail the harrowing circumstances of the accident might well be as distressing to the members of the victim’s family as a photograph of the sort described in the declaration.”); *Bremmer v. Journal-Tribune Publ’g Co.*, 76 N.W.2d 762, 768 (Iowa 1956) (“From a news standpoint the public is interested in the appearance of the body of such a local victim. Such appearance may be pictured by words or by photographs or both.”).

¹⁷⁸*Cf. Von Hannover v. Germany*, App. No. 59320/00, 40 Eur. H.R. Rep. 1, 24 (2004) (“the protection of the rights and reputation of others takes on particular importance” with photographs because the images can contain “very personal or even intimate ‘information’ about an individual”).

One related argument is that images are better at conveying emotion, and emotion is where celebrity value is strongest. The empirical literature on the value of celebrity endorsements generally doesn't distinguish between use of names and use of pictures, most likely because advertisers with actual endorsement contracts tend to use both.¹⁷⁹ However, what we know about images suggests that they do affect memory and emotion differently than words, though not always in predicted or logical directions, especially over the long term.¹⁸⁰

Regardless, the logic of giving celebrities a right to control emotional value only makes sense for advertising. If a noncommercial speaker is using a celebrity because that's the best way to get an emotional message across, then that choice should generally be respected.¹⁸¹ The "images are different" argument seems to reduce to this: images have more value than words, and if there's value, then there should be a right to control that value.¹⁸² But free riding, absent some harm that makes a person worse off than she was before the speech, is generally insufficient to justify regulating even false speech.¹⁸³

There's also a mismatch between the idea that images are more valuable and the claim that transformativeness, specifically, is what protects certain artistic uses. If the raw materials are themselves especially valuable, why can they be taken as long as the taker adds her own creative labor? The reasoning might be that transformative uses offer the public something new, but the doctrine hasn't required defendants to offer new insights or commentary on the celebrity; *Jonah Hex* could have offered new monstrous villains without using the Winter brothers. And *NCAA Football*, for its part, was a new expressive experience that the plaintiffs themselves could not provide. No court has offered an explanation of how much transformativeness is necessary to offset the extra value of the image.

Moreover, the free riding justification neglects visual artists' own input into their representations. Consider Noel Cruz, who repaints licensed dolls so that they look more like their human referents. His dolls cost hundreds and even thousands of dollars more than the mass-produced versions. According to his website:

¹⁷⁹Carsten Erfgen, *Impact of Celebrity Endorsement on Brand Image: A Communication Process Perspective on 30 Years of Empirical Research*, 40 RES. PAPERS ON MARKETING & RETAILING, UNIV. OF HAMBURG 1, 13 (2011) ("Research that considers advertising channel characteristics as a possible intervening variable for celebrity endorsement success is scant: . . . [and only studies] high versus low prestige magazine[s]").

¹⁸⁰*See, e.g.,* Cristina Carmody Tilley, *I Am a Camera: Scrutinizing the Assumption that Cameras in the Courtroom Furnish Public Value by Operating as a Proxy for the Public* 50 (Apr. 4, 2013) (unpublished manuscript), available at <http://perma.cc/M6MX-2K94> (summarizing research on the difference between words and images in news as finding that "general television news featuring live footage or photos is worse than other media at conveying information but potentially better at engaging emotion and developing opinion").

¹⁸¹*Cohen v. California*, 403 U.S. 15 (1971); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (rejecting a requirement that defendant have no adequate alternative to the challenged use as being inadequate to protect public's interest in free expression as applied to intangible rights).

¹⁸²Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 405 (1990) (criticizing "if value, then right" reasoning in intellectual property); *see also* Felix Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809, 815 (1935) (noting the circularity inherent in the argument that there should be an exclusive right because the right would be valuable if it enabled the owner to exclude others).

¹⁸³*See United States v. Alvarez*, 132 S. Ct. 2537 (2012); *cf. Harris v. Quinn*, 134 S. Ct. 2618 (2014) (stating that prevention of free riding is not a compelling interest in the context of compelled payment of union dues).

Noel Cruz is one of the most versatile & distinguished repaint artists in the doll community. He is most recognized for his character & celebrity based dolls due to their uncanny resemblance to the people they portray. . . . His repaints as well as his portraits are done with intricate detail to the point of being naturally lifelike in essence. . . . The beauty of repaints is that almost no two are exactly alike just as no two artists are alike.

What defines Noel's style of repaint is his focus in achieving a sense of both aesthetics and likeness.¹⁸⁴



The distinction *Comedy III* and *Hart* tried to draw between artistry and reproduction collapses: the artistry is in the realism, at least the variety of realism that an audience deems appropriate for the medium. These repainted dolls are, according to Cruz, representations of reality that only he could create.¹⁸⁶ Nor is this claim paradoxical: many artistic traditions identify originality and creativity in each artist's unique version of the truth as she sees it.¹⁸⁷ And society benefits as well from multiple viewpoints and wide variety in art forms, rather than channeling art into a particular relationship with (what the majority deems to be) reality. The veridical force of Cruz's sculptures should not distinguish them from works of poetry or biography, despite the different ways in which the works make their truth claims. Transformativeness as a First Amendment dividing line does not address why creativity in the service of visual realism should be disregarded.

¹⁸⁴NCRUZ.COM, <http://perma.cc/KZX5-D9PF> (last visited Oct. 19, 2014).

¹⁸⁵*Id.*

¹⁸⁶*Cf.* *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903) ("The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone.").

¹⁸⁷*See* Tushnet, *supra* note **Error! Bookmark not defined.**, at 728 ("Our standards for realism change over time. A partial list of visual realisms from the last century alone includes Soviet socialist realism, French poetic realism, Italian neorealism, new realism (1950s), new realism (1980s), and even cubism in its attempts to represent the true restlessness of the human eye. All these realisms had different concerns and produced markedly stylistically distinct works." (footnote omitted)); *see also* LORRAINE DASTON & PETER GALISON, *OBJECTIVITY* 18, 318, 363 (2007) (discussing competing understandings of realism that coexisted and changed).

Finally, related to the free riding argument, one might distinguish between marketability driven by realism and marketability driven by desire to possess some artifact representing the celebrity, and allocate the latter to the celebrity's control. The materiality of the desired object, in this reasoning, would make it less like speech and more like conduct.¹⁸⁸ As with the artistic discrimination inherent in the *Comedy III* approach, that rule would require a level of psychological astuteness I doubt courts can provide. Celebrity fans, like everyone else, routinely make distinctions about the quality of artifacts. Just as Princess Diana connoisseurs might choose a Cruz doll over its mass-market version, purchasers of Saderup's lithographs chose them over undoubtedly cheaper posters of the Three Stooges.¹⁸⁹ The reason, most plausibly, is the artistic specifics of the lithographs.¹⁹⁰ Nor are football fans generally buying EA games as relics of the Saints; they buy the games to play them—that is, to interact with them as communicative works. Even a fetish object theory of the right of publicity, then, couldn't explain the decisions we have.

Ultimately, none of the incompletely theorized reasons why visual discrimination might be justified in the right of publicity context hold up under scrutiny. Comics, video games and other visual media deserve the same treatment as novels and magazine articles. Given that celebrities *shouldn't* have general control over information about themselves—whether that information is conveyed textually or visually—the constitutionally sound approach would be to limit the right of publicity to commercial speech.¹⁹¹ The exception to this approach is the rare *Zacchini* situation in which the right essentially serves as a common-law copyright to protect against retransmission of an entire unfixed performance—a kind of anti-bootlegging rule.¹⁹²

¹⁸⁸Cf. Frederick Schauer, *Speech and "Speech"—Obscenity and "Obscenity": An Exercise in the Interpretation of Constitutional Language*, 67 GEO. L.J. 899, 923 (1979) (arguing that pornography is more like sex than it is like speech).

¹⁸⁹As of July 2014, Saderup lithographs retail at \$20 directly from the artist, *see Order*, GARYSADERUP.COM, <http://perma.cc/6MGM-988S> (last visited Oct. 9, 2014), while Three Stooges posters with a similar pose to that in Saderup's lithograph can be purchased starting from \$4.99, *see ALLPOSTERS*, <http://perma.cc/L6G6-5P2R> (last visited Oct. 9, 2014).

¹⁹⁰And even if they are buying in order to express some sort of affective relation to the celebrity, what's unworthy about that? If wanting a bust of the Rev. Martin Luther King, Jr. is fetishism, how is it different from saluting (or burning) the flag? Cf. *Martin Luther King, Jr. Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697, 703 (Ga. 1982) (finding that sales of a bust of Dr. King violated his right of publicity). Another word for fetishization in this context would be communication. As Professor Diane Zimmerman has written,

[T]he mere fact that information appears on a utilitarian object does not deprive it of its identity as speech. Many products carry such significant communicative freight that they are clearly purchased by consumers for what they "say" rather than for what they do. . . . [S]omeone who wants to wear Tom Hanks' face on his or her chest surely views the t-shirt that carries the image as a secondary and relatively unimportant component of the package. The use of these kinds of images to associate oneself with an era or an attitude toward life or the adoration of a "hero" or celebrity is difficult to distinguish intellectually from the impulses that back in the 1960's led Mr. Cohen to wear his jacket with the logo "Fuck the Draft" into the courthouse or young Mr. Tinker to go to school with a black armband on.

Zimmerman, *supra* note **Error! Bookmark not defined.**, at 63 (footnotes omitted).

¹⁹¹To the extent a right of publicity is constitutional and advisable, it tracks the justification for trademark law. *See* Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn From Trademark Law*, 58 STAN. L. REV. 1161 (2006).

¹⁹²*See, e.g.*, 2 MCCARTHY, *supra* note 2, § 11:55 ("The proper category for *Zacchini*'s claim was the state law of common law copyright, not the right of publicity."); Dogan & Lemley, *supra* note 191, at 1187 (arguing that *Zacchini*'s theory was closest to common-law copyright); Wendy J. Gordon, *An Inquiry into the Merits of*

That limited protection is a far cry from preventing speakers from evoking a celebrity's identity in their own speech.

IV. Copyright Preemption: Sound and Vision

The First Amendment isn't the only federal law in tension with the modern right of publicity. Because courts have refused to limit the right of publicity according to ordinary First Amendment constraints, copyright law has been forced into service, with extremely uneven results. Images aren't the only media responsible for these problems—music, which textually-focused courts also have trouble with, has presented the other key source of confusion¹⁹³—but the law's difficulty conceptualizing the scope of an "image" has substantially contributed to the resulting mess.

The basic problem is this: a creative work is ordinarily exploitable at will by its owner. Where the work depicts an identifiable person, the right of publicity can interfere with that exploitation, even if the person consented to appear in the work.¹⁹⁴ Copyright law has not handled this clash of rights well, and the troubles seem related to confusion about images versus the people they represent, and about how images differ from other modes of representation.¹⁹⁵

The Copyright Act has an explicit preemption provision, § 301, which bars state-law causes of action that confer rights equivalent to copyright.¹⁹⁶ This is designed to ensure that states do not protect that which Congress has determined must be free for all to use, such as ideas or works whose copyright has expired. In a common formulation of the preemption test, a state-law right is preempted under § 301 if it is violated merely by copying something falling within the subject matter of copyright, and if it also lacks an "extra element" such as consumer deception.¹⁹⁷

Copyright: The Challenges of Consistency, Consent and Encouragement Theory, 41 STAN. L. REV. 1343, 1365 n.97 (1989) (noting that state common-law copyright in performances is sometimes called "right of publicity"); cf. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 806 (Cal. 2001) ("To be sure, *Zacchini* was not an ordinary right of publicity case: the defendant television station had appropriated the plaintiff's entire act, a species of common law copyright violation.").

¹⁹³*Compare* *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970) (barring a right of publicity claim against advertising use of a song allegedly associated with the plaintiff, but not performed by her), *with* *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (allowing a right of publicity claim against advertising use of a song associated with the plaintiff and performed by a soundalike).

¹⁹⁴*See* *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284, 1286 (9th Cir. 1999) (Kozinski, J., dissenting from denial of reh'g en banc).

¹⁹⁵For a small sampling of articles on copyright preemption and the right of publicity, see Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1 (2007); James M. Chadwick & Roxana Vatanparast, *The Copyright Act's Preemption of Right of Publicity Claims*, 25 COMM. LAW. 1 (2008); P. Stephen Fardy, *Feet of Clay: How the Right of Publicity Exception Undermines Copyright Act Preemption*, 12 TEX. INTELL. PROP. L.J. 443 (2004); Schuyler Moore, *Straightening Out Copyright Preemption*, 9 UCLA ENT. L. REV. 201 (2002); Richard S. Robinson, *Preemption, the Right of Publicity, and a New Federal Statute*, 16 CARDOZO ARTS & ENT. L.J. 183 (1998).

¹⁹⁶17 U.S.C. § 301 (2012).

¹⁹⁷*See, e.g.,* *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1005 (9th Cir. 2001); 2 MCCARTHY, *supra* note 2, § 11:48.

However, courts often reject the argument that § 301 preempts right of publicity claims, concluding that the right protects an interest distinct from that protected by copyright,¹⁹⁸ even though both rights purportedly have the same incentive-based justification.¹⁹⁹ The “extra element” test has proven insufficient to resolve conceptual difficulties.²⁰⁰ For example, an influential Ninth Circuit case found no preemption where Abercrombie & Fitch used a photo of the plaintiff in a catalog.²⁰¹ By contrast, the same circuit had previously found preemption when a movie actor alleged that his name and likeness appeared in counterfeit films: “[T]he essence of [the actor]’s claim is that the . . . defendants reproduced and distributed the [films] without authorization.”²⁰² Likewise, a California court found right of publicity claims by performers in a film preempted when their complaint was that the film was released without their consent (because they hadn’t been paid).²⁰³

It’s tempting to say that the difference is that Abercrombie & Fitch ran an ad whereas the other defendants didn’t; but the court didn’t take that route, in significant part because § 301 doesn’t easily support drawing the line at ads. Instead, the *Abercrombie & Fitch* court attempted to distinguish these contrary cases by claiming that those claims were based on copyrightable *performances*, whereas the catalog only included uncopyrightable names and likenesses (presented in the catalog text and the photo itself).²⁰⁴ But video doesn’t just contain performances. It contains images—that is, likenesses—and usually includes the performers’ names as well, as it did in the very cases the *Abercrombie & Fitch* court tried to distinguish.²⁰⁵ If the presence of copyrightable material in a photo—the artistic choices made by the photographer that create a particular depiction of the subject—doesn’t lead to preemption because names and likenesses are uncopyrightable, then the presence of copyrightable performances in a video shouldn’t either.

¹⁹⁸See, e.g., *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 623–24 (6th Cir. 2000); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992); see also Ashley D. Hayes, *The Right of Publicity and Protection of Personas: Preemption Not Required*, 51 SYRACUSE L. REV. 1049 (2001) (arguing that the right of publicity protects different interests and thus is not equivalent to copyright); Jeffrey A. Trueman, *Is It Live or Is It a Soundalike?: Federal Copyrights in Soundalike Recordings and Preemption of State Publicity Claims*, 1 CHI.-KENT J. INTELL. PROP. 80 (1999) (same type of argument).

¹⁹⁹See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (justifying right of publicity with economic incentive theory); *Laws v. Sony Music Entm’t*, 448 F.3d 1134, 1145 (9th Cir. 2006) (“Both copyright and the right of publicity are means of protecting an individual’s investment in his or her artistic labors.”). Indeed, some have suggested that the right approved by *Zacchini* should properly be understood only as a kind of common-law copyright in an entire performance, and that on its own terms the case should not apply to many situations not involving direct copying of an entire performance. See Zimmerman, *supra* note **Error! Bookmark not defined.**

²⁰⁰See Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 228–29 (2002) (summarizing criticisms of the extra element test).

²⁰¹*Downing*, 265 F.3d 994.

²⁰²*Jules Jordan Video, Inc. v. 144942 Canada, Inc.*, 617 F.3d 1146, 1155 (9th Cir. 2010); see also *Milo & Gabby, LLC v. Amazon.com, Inc.*, No. C13-1932, 2014 WL 1411849 (W.D. Wash. 2014) (finding § 301 preemption of right of publicity claim based on reproduction of photos showing plaintiffs’ children; “the essence of Plaintiffs’ right of publicity claim is that Amazon reproduced and distributed photographs of the . . . children without authorization to do so”).

²⁰³*Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 651 (Cal. Ct. App. 1996) (finding claims by performers in film preempted; “it was not merely [plaintiffs’] likenesses which were captured on film—it was their dramatic performances which are . . . copyrightable”).

²⁰⁴*Downing*, 265 F.3d at 1005 n.4.

²⁰⁵See *Jules Jordan*, 617 F.3d at 1154; *Fleet*, 58 Cal. Rptr. 2d at 647 (allegations in video case included unauthorized use of names and likenesses).

The Seventh Circuit also found no preemption in a photo reuse case, *Toney v. L'Oreal USA*, relying heavily on the influential treatise by J. Thomas McCarthy.²⁰⁶ McCarthy reasons that a photograph of a person is not the same thing as the person depicted in the photo and that the right of publicity implicates only the latter.²⁰⁷ According to McCarthy, a photograph “is merely one copyrightable ‘expression’ of the underlying ‘work,’ which is the plaintiff as a human being. There is only one underlying ‘persona’ of a person protected by the right of publicity.” By contrast, “[t]here may be dozens or hundreds of photographs which fix certain moments in that person’s life.”²⁰⁸ While McCarthy is correct to distinguish the person from a photograph of a person (and setting aside his unitary theory of the self), the fact that a persona is not copyrightable does not end the inquiry even under § 301. Facts are not copyrightable, nor are works that are in the public domain because they were published a hundred years ago, yet a state law that protected either as such would plainly be preempted. Congress intended to preclude states from giving copyright-like protection to matter within the general scope of copyright even if that matter was not copyrightable.²⁰⁹

Regardless, *Toney* concluded that the photographic subject’s identity wasn’t “fixed” because it extended past any particular photograph.²¹⁰ Thus, there was no “work of authorship” at issue in her claim, and no right equivalent to copyright.²¹¹ Notably, the Seventh Circuit dismissed the relevance of its previous decision finding preemption of baseball players’ claims against television broadcasts of their games:

[That earlier case, *Baltimore Orioles*,] simply does not stand for the proposition that the right of publicity as protected by state law is preempted in all instances by federal copyright law; it does not sweep that broadly. . . . *Baltimore Orioles* holds that state laws that intrude on the domain of copyright are preempted even if the particular expression is neither copyrighted nor copyrightable.²¹²

The court did not explain what made the players’ claim in *Baltimore Orioles* intrude on the domain of copyright, given that they, too, were making claims based on appropriation of their likenesses, or why the plaintiff’s claim didn’t so intrude notwithstanding that the defendants

²⁰⁶*Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 908–09 (7th Cir. 2005). But see *Balt. Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663, 676–78 (7th Cir. 1986) (finding that baseball players’ right of publicity claims based on broadcasts of games were preempted because the claims fell within the subject matter of copyright and were equivalent to the baseball club/copyright owner’s exclusive right to distribute the broadcast).

²⁰⁷2 MCCARTHY, *supra* note 2, § 11:52.

²⁰⁸*Id.*; cf. *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (holding that a voice is not copyrightable; by the same logic, there are many recordings in which a voice could be fixed).

²⁰⁹See, e.g., *Montz v. Pilgrim Films & Television, Inc.*, 649 F.3d 975, 979 (9th Cir. 2011) (“For preemption purposes, ideas and concepts that are fixed in a tangible medium fall within the scope of copyright . . . despite the exclusion of fixed ideas from the scope of actual federal copyright protection.”).

²¹⁰*Toney*, 406 F.3d at 910; see also *KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d 713 (Cal. Ct. App. 2000) (models’ right of publicity claims against unauthorized publisher of photos were not preempted because a likeness is not copyrightable).

²¹¹*Toney*, 406 F.3d at 910; see also *id.* (“Identity, as we have described it, is an amorphous concept that is not protected by copyright law; thus, the state law protecting it is not preempted.”).

²¹²*Id.* at 910–11.

licensed the copyright in the picture of her that they used. Future claimants were left to speculate.²¹³

When the medium is nonvisual, the cases have a different pattern. A number of courts will find preemption when the defendant used a song without the performer's consent but with a copyright license.²¹⁴ These cases have not successfully distinguished the song and photograph cases: the right of publicity purports to cover both image and voice, but somehow the courts found something extra in the image that allowed the right of publicity claim to survive copyright preemption, and not something extra in the voice.²¹⁵ This divergence may also be related to the idea that the creator of a visual image—the photographer—doesn't do as much work as the creator of a sound recording, since a photograph simply represents reality. The photograph's copyright might then seem less important than a copyright in a sound recording. The Ninth Circuit offered a more attractive, but doctrinally inaccurate, distinction between the photo and

²¹³There was a violation of a contractual restriction limiting the use of the picture in *Toney*; the court could have rested its decision entirely on contract law, because an actual agreement between the parties can provide the necessary extra element to avoid preemption, but it didn't.

²¹⁴*See, e.g.,* *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1139–41 (9th Cir. 2006) (holding that a sound recording in which a performance was fixed was within the subject matter of copyright, and thus performer's claims based on unauthorized use of the sound recording were preempted); *cf. Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970) (rejecting claim based on use of a song allegedly associated with plaintiff, and singers dressed like plaintiff, in a television advertisement); *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (explaining that *Sinatra* was a preemption case and holding that a claim based on imitation of *voice* was not preempted). *But see* *Brown v. Ames*, 201 F.3d 654 (5th Cir. 2000) (finding no preemption where sound recordings were reproduced and plaintiffs were truthfully identified as the singers through use of their photos and names). *Laws* involved use of a sample of plaintiff's performance in a new sound recording; it could have been much more easily resolved by a right of publicity that covered only commercial uses. The court distinguished the seemingly similar claim in *Midler* by explaining that the *Laws* defendant licensed the use of the recording in which the plaintiff's voice was fixed, whereas the defendant in *Midler* only licensed the use of the musical work, not a recording of Midler herself. *Laws*, 448 F.3d at 1140–41.

²¹⁵*See Laws*, 448 F.3d at 1141 (“[F]ederal copyright law preempts a claim alleging misappropriation of one's voice when the entirety of the allegedly misappropriated vocal performance is contained within a copyrighted medium [T]he fact that the vocal performance was copyrighted demonstrates that what is put forth here as protectible is *not* 'more personal than any work of authorship.'” (citation omitted)). The court stated that its rulings were consistent with the plaintiff victories in two previous voice imitation cases, because “[n]either of those imitations was contained in a copyrighted vocal performance.” *Id.* This just wasn't true, since the imitators' performances were fixed and copyrightable in themselves. What was true was that the plaintiff in *Laws* had consented to the fixation of her voice in the recording that was used in *Laws*, and that might provide the basis for a distinction, since the owner of the copyright in the sound recording could reasonably expect that the performer wouldn't interfere with the copyright owner's exercise of rights, absent some contractual reservation. *See Rothman, supra* note **Error! Bookmark not defined.**, at 231 (making a similar argument about the irrelevance of copyrightability and the relevance of consent).

song cases: the photo cases involved advertising uses.²¹⁶ If that had been the rationale of *Abercrombie & Fitch*, it would have been a much better and more limited decision.²¹⁷

A solid line between advertising and non-advertising uses would be a good idea, but current preemption doctrine doesn't achieve that result. Instead, courts have inconsistently used preemption to limit claims against noncommercial speech, since the First Amendment isn't doing the job. There are exceptions in both directions, but courts do seem more likely to uphold right of publicity claims based on the reuse of a copyrighted work in an ad, and to reject them when they're based on the reuse of a copyrighted work for an ordinary, non-advertising exploitation of the work, such as releasing videotapes of a performance recorded with the performer's consent.²¹⁸

McCarthy defends this result on the grounds that a right of publicity claim against a reuse of a recorded performance in a non-advertising context meets both prongs of § 301 preemption: it is within the subject matter of copyright, he says, because the use involves "a copyrighted performance per se" and not voice or appearance.²¹⁹ In addition, the claim is equivalent to a copyright right "because it complains solely of a reproduction or performance of the recorded performance in an accused expressive work that is not an advertisement or promotion."²²⁰ Thus, there's no "additional element" of advertising or promotion.²²¹

²¹⁶*See Laws*, 448 F.3d at 1141 ("Abercrombie had not merely published the photograph. Rather, it published the photo in connection with a broad surf-themed advertising campaign, identified the plaintiffs-surfers by name, and offered for sale the same t-shirts worn by the plaintiffs in the photo. By doing so, it had suggested that the surfers had endorsed Abercrombie's t-shirts."). The *Laws* court also contended that the previous cases involved the use of names and likenesses, which aren't within the subject matter of copyright, *id.*, but the use the *Laws* plaintiff sued over also involved the use of her name, *id.* at 1143, and so that couldn't provide a factual basis for distinguishing the cases. Instead, the court apparently allowed the use of the performer's name to accurately identify her where copyright preemption prevented a claim based on the performance itself, a sort of tag-along preemption.

²¹⁷Possibly underlying the divergent results is some idea of where the selling power came from in each advertisement. In this interpretation, the picture in the *Abercrombie & Fitch* case was transparent and only represented the reality of the surfers, and any picture of them could have done the same job of selling the products using them. Songs might seem more specific, more tied to a particular performance, thus more dependent on the copyrightable elements of the advertisement—although the empirics of this are debatable at best. There's an interesting factual wrinkle here—Abercrombie & Fitch sold replicas of the clothes the surfers were wearing in that particular photo. *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1000 (9th Cir. 2001). So in some sense, no other photo might have done for that specific catalog, though perhaps the company would have created different clothes using a different photo.

²¹⁸*See, e.g., Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1029 (3d Cir. 2008) (finding no preemption for advertising use: "The rationale is that state law has a role in regulating practices of trade, including advertising. But limiting the way that material can be used in expressive works extends beyond the purview of state law and into the domain of copyright law."); *see also* 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[B][3][b][iv][1] (rev. ed. 2013) (surveying relevant case law and finding a general advertising/non-advertising divide in preemption); *cf. Ray v. ESPN, Inc.*, No. 13-1179-CV, 2014 WL 2766187, at *5 (W.D. Mo. Apr. 8, 2014) (finding preemption where defendant "air[ed] video recordings depicting [plaintiff] in a 'work of authorship,' which is plainly encompassed by copyright law"). *But cf. Kristen E. Riccard, Product Placement or Pure Entertainment? Critiquing a Copyright-Preemption Proposal*, 59 AM. U. L. REV. 427 (2009) (arguing that the commercial/noncommercial divide for finding preemption doesn't make sense and improperly weighs the state publicity interest compared to the federal copyright interest).

²¹⁹2 MCCARTHY, *supra* note 2, § 11:55 & n.9 (advocating for preemption when a defendant "reproduces a recorded performance in an expressive, non-advertising medium").

²²⁰*Id.*

²²¹*Id.*

McCarthy's explanation isn't persuasive, even if his preferred policy outcome makes sense. As to the first point, the idea that a non-advertising use involves "a copyrighted performance per se" can't distinguish a noncommercial use from an ad. McCarthy asserts that "[t]he subject matter [where a performance is used in advertising] is identity, not the recorded performance per se."²²² Unless the defendant is engaged in live, unrecorded performance, the defendant's use will involve a copyrighted representation of the subject. Voice or appearance, if those are present in an ad, will only be present in some fixed, expressive work, just as they would be in a non-advertising work.²²³ Further, a non-advertising work may well use a celebrity's name, which is not protected by copyright and which is a core component of "identity." To say that a right of publicity claim has identity as its subject matter if and only if it is incorporated in an ad is merely to state a conclusion.

Perhaps the thought is that, in an ad, it's the celebrity's aura that's being sought, whereas in a non-ad it's just the specific fixed performance. But that's a factual distinction, not a conceptual one, and it's not very persuasive on its own terms. Ads that use a particular sound recording, or a particular well-known sports play, are trading on a specific fixed performance—other instances of the celebrity's work wouldn't make the same point.²²⁴ And non-advertising uses can readily appeal to the overall aura of a celebrity, as a notable sports painter did when he painted Tiger Woods in multiple poses.²²⁵

But it is McCarthy's second point, his contention that there's no "extra element" to a right of publicity claim beyond mere copying unless the defendant's use is in an ad, that makes clear that the preemption for which he is arguing isn't § 301 preemption.²²⁶ Requiring that an

²²²*Id.* § 11:55; cf. Thomas F. Cotter & Irina Y. Dmitrieva, *Integrating the Right of Publicity with First Amendment and Copyright Preemption Analysis*, 33 COLUM. J.L. & ARTS 165 (2010) (arguing for conflict preemption of right of publicity claims in cases involving noncommercial speech, unless the state interest is in protecting personal privacy, individual autonomy or consumer deception); Paul Heald, *Federal Intellectual Property Law and the Economics of Preemption*, 76 IOWA L. REV. 959, 998–1000 (1991) (suggesting preemption when the right gives incentives to create a copyrighted work and not when the incentives are to create a non-copyrighted work).

²²³*Cf.* *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) (advertising is within the subject matter of copyright, if the work is otherwise copyrightable).

²²⁴*See, e.g.,* *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008) (sports announcer's specific statement about football added to promotional value of film); *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56 (2d Cir. 2001) (advertisement was structured around Miss Piggy's insertion into the role of "The Girl from Ipenema," where the song was performed by plaintiff); *see also* *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (Ford's campaign depended on evoking a particular generational moment, using a song associated with Bette Midler from the relevant period).

²²⁵*See* *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F. 3d 915, 936 (6th Cir. 2003) (finding that a painting showing three different views of Tiger Woods implicitly argued that he deserved a place in the pantheon of golf).

²²⁶*See also* *Chadwick & Vatanparast, supra* note **Error! Bookmark not defined.**, at 6 ("[R]ight of publicity claims should be preempted unless the use at issue (1) goes beyond the reproduction, display, distribution, or sale of a copyrighted or copyrightable work containing a person's name, likeness, or voice, for example a photograph, movie, or audio recording; and (2) states or implies the endorsement of products or services."). The idea of "going beyond" copying in this context expresses a strong feeling that an advertisement is different from non-advertising speech, but doesn't usefully distinguish the right of publicity from misappropriation, which is regularly preempted when all it requires is copying plus some concept of unfairness. *See, e.g.,* *LaChapelle v. Fenty*, 812 F. Supp. 2d 434, 444 (S.D.N.Y. 2011) ("[U]nfair competition and misappropriation claims grounded *solely* in the copying of a plaintiff's protected expression are preempted by the Copyright Act.") (internal quotation marks and brackets omitted).

actionable use be in an ad isn't an "extra element."²²⁷ Although the case law is confused, narrowing the set of actionable cases (e.g., *intentional* copying, or here, copying in the form of an ad) does not add an extra element, as long as copying *within the set* is all that is required for liability.²²⁸ Rather, an extra element requires something in addition to copying in order to trigger liability, such as consumer confusion about whether a celebrity endorsed a product because a picture of her appeared in an ad for that product. Confusion is an element that must separately be proven and that would make the advertising actionable even if the confusion stemmed from something noncopyrightable, such as use of her name alone without a photo.²²⁹

A more persuasive explanation for these inconsistent results is that courts think that allowing performers to control ordinary, non-advertising exploitation of a copyright would interfere too much with copyright owners' rights, and allowing them to control ads generally doesn't (at least when the ads involve visual uses as opposed to sound recordings).²³⁰ To put it another way, the right of publicity's core function is to control uses in advertising; copyright's core function is not. One could even reason that, whether or not a state requires written consent to avoid a right of publicity claim, for federal purposes a voluntary appearance in a copyrighted work constitutes an implicit license to the copyright owner to exploit the performer's right of publicity, at least up to the point where the work is used to sell some other product. However the argument is framed, this implicit reasoning is fundamentally about conflict preemption, not grounded in § 301's "extra element" test.²³¹ Conflict preemption occurs when a state law

²²⁷Cf. Bauer, *supra* note **Error! Bookmark not defined.**, at 80 (concluding that courts sometimes "incorrectly allow the state law claims to proceed by giving too narrow a scope to the 'subject matter of copyright' or by taking too credulous a view of the proffered 'extra element'"); see also Moore, *supra* note **Error! Bookmark not defined.**, at 204 (arguing that current application of the extra element test is "circular in practice," and that the cases are "ad hoc, inconsistent, or wrong").

²²⁸Computer Assocs. Int'l Inc. v. Altai, Inc., 982 F.2d 693, 717 (2d Cir. 1992) ("An action will not be saved from preemption by elements such as awareness or intent, which alter 'the action's scope but not its nature'" (citation omitted)); Laws v. Sony Music Entm't, Inc., 448 F.3d 1134, 1144–45 (9th Cir. 2006) (commercial use requirement was not a sufficient extra element; it did not transform the nature of the action, because the right at issue was still violated by reproduction).

²²⁹See, e.g., Samara Bros., Inc. v. Wal-Mart Stores, Inc., 165 F.3d 120, 131 (2d Cir. 1998), *rev'd on other grounds*, 529 U.S. 205 (2000). However, the "inherent misrepresentation" involved in copying is not enough to avoid preemption. Kluber Skahan & Assocs., Inc. v. Cordogen, Clark & Assoc., Inc., No. 08-cv-1529, 2009 WL 466812, at *10 (N.D.Ill. Feb. 25, 2009).

²³⁰To the extent that copyright does provide incentives to create, the advertising/non-advertising distinction may not be well-justified. Copyright owners of noncommercial works—songs, for example—may receive marginal incentive benefits from the prospect of licensing their works for use in advertising. As a result, interfering with the ability to use existing, initially non-advertising works in later advertising conflicts with the copyright owner's exclusive rights in the same way that interfering with the ability to create non-advertising derivative works does, though perhaps the interference is worth tolerating for other reasons, such as the risks of creating a perceived endorsement or a person's special interest in avoiding having her identity used for advertising.

²³¹See Laws, 448 F.3d at 1145 ("We sense that, left to creative legal arguments, the developing right of publicity could easily supplant the copyright scheme. This, Congress has expressly precluded in § 301. Were we to conclude that [plaintiff's] voice misappropriation claim was not preempted by the Copyright Act, then virtually every use of a copyrighted sound recording would infringe upon the original performer's right of publicity It is hard to imagine how a copyright would remain meaningful if its licensees were potentially subject to suit from any performer anytime the copyrighted material was used."). The court speaks of § 301, but its concerns are really about the integrity of the copyright system.

interferes too much with a federal statute's aims, and can operate even when there's also an explicit preemption provision.²³²

Recall that the incentive story for the right of publicity—that the right encourages the production of celebrity identity—is highly similar to the incentive story for copyright, given that celebrity identity is essentially always disseminated through expressive works. Conflict preemption is often appropriate where a state tries to encourage production of works within the general scope of copyright or patent law, regardless of whether those works are copyrightable or patentable.²³³ The incentive overlap when a person has voluntarily agreed to be in a copyrighted work therefore provides additional justification for conflict preemption, supplementing copyright owners' interest in exploiting their works as Congress intended them to be free to do.

Professor Jennifer Rothman has provided the most comprehensive examination of conflict preemption beyond § 301.²³⁴ She argues that the right of publicity is justified not just by incentive theory, but also by natural rights to protect one's identity and by a concern about unjust enrichment.²³⁵ Nonetheless, the right ought to be limited to allow others appropriate freedoms. Rothman suggests that conflict preemption should preclude a right of publicity claim when: (1) the claim is based solely on appropriation of a "persona" rather than a likeness, image, voice or name;²³⁶ (2) the right holder consented to the original work and the use is either by the copyright holder or a licensee or (3) the right holder consented to the original work and the work is used by the public in a way that is explicitly allowed by the Copyright Act.²³⁷

Rothman's second scenario would allow most of the uses in advertising in the cases discussed above.²³⁸ Advertisers could license an image of a celebrity taken with her consent,²³⁹ though they couldn't commission a realistic drawing without infringing, even though both the

²³²See *Geier v. Am. Honda Motor Co.*, 529 U.S. 861, 867 (2000).

²³³See *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964) ("To allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to be patented would be to permit the State to block off from the public something which federal law has said belongs to the public."); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231–32 (1964) (same); see also *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 156–57 (1989) (explaining that states can pursue consumer protection objectives, but not seek to encourage production directly by granting monopoly rights over federally unprotected articles). But see *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974) (finding no conflict between state trade secret law and patent law where the type of conduct targeted was substantially different, even if trade secret protection also had incentive effects). Although the Court mostly discussed patent law in these cases, it has made clear that its rationale applies to both patent and copyright. See *Compco*, 376 U.S. at 237; *Sears*, 376 U.S. at 232–33. Congress' power to grant exclusive rights in creative works and inventions, after all, comes from the same constitutional clause.

²³⁴Rothman, *supra* note **Error! Bookmark not defined.**; see also Cotter & Dmitrieva, *supra* note 222 (arguing for conflict preemption principles to achieve similar results).

²³⁵See Rothman, *supra* note **Error! Bookmark not defined.**, at 245–46.

²³⁶This element of Rothman's test solves a separate problem, which I have not addressed in text, about the expansion of the right of publicity so that it now covers even reminding people of a celebrity, regardless of whether it is obvious that the celebrity herself is not being represented. See, e.g., *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (Kozinski, J., dissenting from denial of reh'g en banc).

²³⁷See Rothman, *supra* note **Error! Bookmark not defined.**, at 252.

²³⁸See *id.* at 250 (arguing that, where the subject consented to appear in the work, the copyright owner should be able to use works in advertising by default in the absence of a contract to the contrary).

²³⁹*Cf. Jones v. Corbis Corp.*, 815 F. Supp. 2d 1108 (C.D. Cal. 2011). The celebrity might nonetheless have a false endorsement claim in some circumstances. The proper reach of trademark law, including false endorsement, is beyond the scope of this Article.

photographer and the graphic artists own copyrighted works. The preemption Rothman proposes would stem from the interference with the full exploitation of a voluntarily obtained representation of the celebrity. Consent doesn't fully solve the copyright conflict Rothman is targeting, since there are many situations in which a person's consent isn't required to incorporate them into a copyrighted work (e.g., a news photo of a newsworthy event), and the owner of such a work should also be able to exploit it. Moreover, there are public policy reasons to allow some unconsented uses of copyrighted works in ads.²⁴⁰ Similar rationales apply to the right of publicity: why not allow a Lindsay Lohan parody in an ad even if she didn't consent to her mug shot? But that may just be to say that preemption can't do all the work of protecting lawful commercial speech from the right of publicity.²⁴¹ Ultimately, the First Amendment needs to play a role as well.

In practice, Rothman's proposal would mean that preemption would preclude right of publicity claims when the copyrighted work being used is a standard sound recording, where consent is virtually inherent in the existence of the work. Preemption would by contrast be patchy for film and images. It would protect the rights of copyright owners of planned audiovisual productions—feature films and TV shows—but not the rights of news photographers or paparazzi. Here we have a distinction between images and sounds that stems from conditions of production, which even if imperfect is more justifiable than the other distinctions in this field.

Why are all these attempts at line-drawing so messy? Preemption has given courts such conniptions because they lose track of the intangible rights conferred by copyright when looking at the intangible rights conferred by the right of publicity. A celebrity may be represented in an image, but not completely contained or defined by it; the person has an existence beyond the image. According to the dominant analysis, this existence then means that regulation of the content (the celebrity identity as captured in the image) is not the same as regulation of the image itself, which would be preempted by copyright. However, under current copyright law, the copyrighted work itself has the same feature—its legal existence extends beyond its fixation to cover substantially similar copies and derivative works. The rights conferred by ownership extend beyond the work's four corners, to all the possible works that would qualify as substantially similar or derivative works.²⁴² Many of those substantially similar or derivative

²⁴⁰See, e.g., *Sony Computer Entm't Am., Inc. v. Bleem, LLC*, 214 F.3d 1022 (9th Cir. 2000) (comparative advertising); *Eveready Battery Co., Inc. v. Adolph Coors Co.*, 765 F. Supp. 440 (N.D. Ill. 1991) (parody).

²⁴¹See Rothman, *supra* note **Error! Bookmark not defined.**, at 255, 261 (stating that preemption should not apply when the copyright owner didn't consent to the use, though apparently assuming that such uses would always infringe rather than being potentially fair use).

²⁴²On this point, scholars across the spectrum from copyright skeptics to copyright high-protectionists agree. See, e.g., JULIE E. COHEN, *CONFIGURING THE NETWORKED SELF: LAW, CODE, AND THE PLAY OF EVERYDAY PRACTICE* 76 (2012) ("Identification of expression divorced from animating ideas as the appropriate subject of ownership . . . generates broad rights that negate defenses based on the transposition of expression into different forms. Thus it makes sense to conclude, for example, that the copyrightable expression in a film inheres in its characters in a way that transcends the particular actions scripted for them . . ."); ROBERT MERGES, *JUSTIFYING INTELLECTUAL PROPERTY* 59 (2011) ("The way IP law operates, the creator of the work will almost always be able to obtain a property right that extends beyond the original embodiment of the work. The property right will almost always cover the original embodiment plus some number of variations on the original . . . It is this class or genus, this set of all variants on the original work, that is the real subject of IP law."); Anthony Casey & Andres Sawicki, *Copyright in Teams*, 80 U. CHI. L. REV. 1683, 1726–27 (2013) ("The first novel in a series has no protection until the novel is written; but after that, something closer to the idea of a sequel has substantial protection under the

works would also use the celebrity's identity, precisely because of their similarity to the original. Thus, neither the celebrity image nor the copyrighted work in which it appears is limited to one particular instantiation.

This difficulty grappling with the emanations of rights also occurs in another area of intersection in copyright and publicity law: when the relevant images are of actors "in character," not just as themselves, copyright owners claim to own the character as an overall entity and individual images that depict the character.²⁴³ Courts upholding "character copyrights" generally recognize a copyright in the visual aspects of character, detached from the particular work in which the character appears, even when the visual appearance derives from the physical attributes of the actor portraying the character.²⁴⁴ Thus, MGM would control the copyright in a doll depicting a Dorothy Gale who looks like Judy Garland, even though a doll isn't substantially similar to the overall work MGM owns, *The Wizard of Oz*. But if the copyright owner owns rights in the visual aspects of character detached from any particular work, that seems very hard to distinguish from an actor's likeness—both rights would seem to

derivative-works right And at a minimum, the derivative-works right protects expression that the holder of the right has yet to fix in a tangible medium."); Daniel Gervais, *The Derivative Right, or Why Copyright Law Protects Foxes Better Than Hedgehogs*, 15 VAND. J. ENT. & TECH. L. 785, 792 (2013) ("Indeed, introducing a right against unauthorized translations and dramatizations implied that *something protectable lay beneath a work's literal surface*. What now may seem obvious was in fact a major shift. It opened up a new path for copyright under which substantial as well as literal copies could infringe. It also created a climate hospitable to a significant expansion of copyright" (footnote omitted)); Michael J. Madison, *The End of the Work as We Know It*, 19 J. INTELL PROP. L. 325, 352 (2012) ("Over the course of the nineteenth century, copyright law evolved the idea of the work as a thing abstracted from material form.")

²⁴³See, e.g., Warner Bros. Entm't, Inc. v. X One X Prods., 644 F.3d 584 (8th Cir. 2011) (*Wizard of Oz* characters); Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co., Inc., 900 F. Supp. 1287 (C.D. Cal. 1995) (James Bond).

²⁴⁴See Kurtz, *supra* note **Error! Bookmark not defined.**, at 448 (noting this problem and arguing that "the creative expression protected by copyright cannot be found in the physiognomy of the actor or the shape of ordinary clothing. Rocky looks remarkably similar to Rambo and James Bond, played by a variety of actors, appears differently from film to film"). Kurtz concludes that, for preemption purposes, copyright owners should be able to exploit their characters in non-advertising uses, and thus to use elements of a performer's persona to the extent that the performer was performing the character. *Id.* at 470 ("The basic question that should be asked is whether it is the character that is being used, or whether it is simply the performer in disguise. If the value of the challenged work is derived primarily from the character, rather than the fame of the actor playing the character, the right of publicity should not apply."). I find this reasoning unsatisfying, since Kurtz relies on the claim that "the bulk of the economic value comes from the portrayal of the character rather than the resemblance to the actor." *Id.* This doesn't seem to describe many popular characters tightly associated with their actors, such as Arnold Schwarzenegger's iconic Terminator and Sylvester Stallone's iconic Rambo. Cf. Michael J. Albano, *Nothing to "Cheer" About: A Call for Reform of the Right of Publicity in Audiovisual Characters*, 90 GEO. L.J. 253, 288, 290 (2001) (pointing out that it is difficult for courts to "accurately distinguish between those elements of a character created solely by writers and those attributed to [the] human persona," but at the same time proposing to "grant an actor a federal right of publicity in a character she portrays when she is the substantial creative force behind the character or when the character has become so associated with the actor that they are inseparable to the public eye"). Even if these characters could be rebooted with new actors, like the *Star Trek* actors, that doesn't mean that the economic value didn't begin with tight identification between the actor and the role. Or consider Brad Pitt and Angelina Jolie's *Mr. and Mrs. Smith*. Could anyone seriously contend that the gun-toting titular characters are in any way recognizable other than as extensions of the stars' personae? Yet it seems to me that the copyright owner of that movie should have as much right to exploit its copyright as the copyright owner of *Star Trek*. Ultimately, determining where "value" comes from in an artistic work is likely to remain as tricky an endeavor in dividing characters from their actors as it is in evaluating transformativeness in First Amendment defenses to right of publicity claims. The game of regulating noncommercial speech isn't worth the candle.

cover the same subject matter and to be infringed simply by copying. Right now, copyright owners control “characters” as against third parties, while performers’ publicity rights may interfere with licensed exploitation of those characters.²⁴⁵ But the very detachability of a visual character from the specific work in which she appears should lead to the conclusion that both rights protect the same subject matter, and thus that right of publicity claims based on character reuse are preempted.

The ultimate issue is that copyright, like the right of publicity, extends rights in a work beyond its tangible contents to a broader “copyrighted work.” Thus, the idea that a right of publicity/persona is also intangible and impossible to nail down in any one physical instantiation isn’t itself a barrier to preemption, especially conflict preemption. Where the right of publicity has the same incentivizing aim, but protects what copyright law chooses to leave unprotected—the fact of a celebrity name, appearance, etc., or a fair use—conflict preemption would be appropriate. Use in advertising may implicate endorsement concerns and avoid conflict preemption, but copyright should be a barrier to celebrity control of artistic works. None of this analysis directly depends on a special role for images, but the presence of so many image-related cases seems to have contributed to the multiple inconsistencies permeating preemption analysis in right of publicity law.

V. Conclusion

I have largely relied on a syllogism throughout: to begin with, the First Amendment doesn’t allow celebrities to control most uses of their names in non-advertising speech, even when that speech is sold for profit. If, as I argue, there’s no constitutionally relevant distinction between names and images, then allowing celebrities to control most uses of their images in non-advertising speech is equally unconstitutional. I haven’t spent much time on the first part of the argument. In theory, we might respond to this inequality by giving celebrities expanded control over textual uses as well. As the *Restatement of Unfair Competition*’s definitional exclusion of biographies and the like from the right of publicity shows,²⁴⁶ however, it has generally seemed obvious even to proponents of the right that others’ interests in freedom of expression trump celebrity interests in controlling non-advertising writing about them, in the absence of defamation or invasion of privacy.

As many other scholars have written, freedom to engage in discourse about celebrities is an important part of our public discussions about culture, politics, morality and other pressing issues.²⁴⁷ Celebrities, by concentrating our attention and interest, are good to think with.

²⁴⁵See *Wendt v. Host Int’l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (allowing actors who portrayed *Cheers* characters to prevent the owner of the *Cheers* copyright from licensing creation of derivative works).

²⁴⁶RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. a (1995).

²⁴⁷A small sampling includes: Stephen R. Barnett, *First Amendment Limits on the Right of Publicity*, 30 TORT & INS. L.J. 635 (1995); Rosemary J. Coombe, *Author/izing the Celebrity: Publicity Rights, Postmodern Politics, and Unauthorized Genders*, 10 CARDOZO ARTS & ENT. L.J. 365 (1992); Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853 (1991); David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1 (2011); Eugene Volokh, *Freedom of Speech and The Right of Publicity*, 40 HOUS. L. REV. 903 (2003); Diane Leenheer Zimmerman, *Fitting Publicity Rights Into Intellectual Property And Free Speech Theory: Sam, You Made The Pants Too Long!*, 10 DEPAUL-LCA J. ART & ENT. L. 283 (2000); see also Ralph S. Brown, *Copyright and Its*

Whether it's the appropriate effect of domestic violence on a person's career,²⁴⁸ the wisdom of prophylactic mastectomies for women with a genetic predisposition to breast cancer,²⁴⁹ the implications of public sexual expression and of white women imitating African-American culture,²⁵⁰ or any other topic of public note, celebrities offer important reference points enabling broader discussion. Moreover, the First Amendment elsewhere provides a strong default rule: the speaker does not need to justify her choice of how to speak in the first instance. Instead, the government must offer a good reason to regulate her speech, even if that speech seems trivial, exploitative or merely entertaining without broader implications. Our constitutional history provides too many examples of those in power judging the speech of the powerless to be unworthy to allow us to say with confidence that *NCAA Football* or *Grand Theft Auto* are unimportant speech.

Largely insulated from these concerns, the right of publicity has been making bad law for decades now. One reason is its tight link with the legal regulation of images, where courts are routinely inconsistent. The tortured path of the right of publicity demonstrates the dangers of insufficiently defining the scope of an intellectual property right, especially when the regulated texts are incompletely understood by courts. More serious attention to the communicative nature of images, as opposed to continued equation of an image with the person it represents, would lead to a substantial contraction of the right of publicity. While there may well be normative and practical reasons to provide a special legal rule for unconsented representation of people in ads, current law wrongly allows the suppression of substantial amounts of non-advertising speech—when the speech involves images. Instead of corroding free speech rights, our doctrine should protect artists who draw with their pencils as much as artists who write with them.

Upstart Cousins: Privacy, Publicity, Unfair Competition: The Sixteenth Donald C. Brace Memorial Lecture, 33 J. COPYRIGHT SOC'Y 301 (1986) (criticizing expansion beyond false endorsement); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127 (1993) (making similar claims about the importance of celebrity representations for making meaning, but expressing lack of faith in courts' willingness to use the First Amendment to restrict the right of publicity).

²⁴⁸See, e.g., Barry Petchesky, *Someone Is Lying About Whether The NFL Saw the Ray Rice Tape*, DEADSPIN (Sept. 8, 2014, 11:21 AM), <http://perma.cc/RGS3-W9EP> (discussing controversy over the NFL's mild sanction of the Baltimore Ravens' Ray Rice for brutally assaulting his fiancée).

²⁴⁹Justin Moyer, *Dueling Studies: The 'Angelina Jolie Effect' Is Influencing Women Fighting Cancer—but the Influence May Not Do Much Good*, WASH. POST (Sept. 3, 2014), <http://perma.cc/R37N-SVFJ>.

²⁵⁰Tressie McMillan Cottom, *Brown Body, White Wonderland*, SLATE (Aug. 29, 2013, 8:04 AM), <http://perma.cc/46S-4S2J>.